(1) Supreme Court, U.S.
FILED

No. 001651 APR 30 2001

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IN THE

Supreme Court of the United States

NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

1. **"Second Service" In the Courtroom:** If a defendant attends a live, court-noticed FED. R. CIV. P. 12(b)(2) hearing, and enters the forum to assert the defense of lack of personal jurisdiction, but plaintiff attempts a "second service" of summons in the courtroom, does defendant thereby lose the very defense that induced him to be present, or may defendant press his defense?

2. **"Second Service" – Constitutional Due Process:** Does assertion of personal jurisdiction, when minimum contacts are otherwise lacking, based on in-courtroom "second service," violate either prong of the applicable Due Process standard – "minimum contacts" among the defendant, forum and cause of action, or "fair play and substantial justice?"

3. **"Second Service" – General Rule of Process Immunity:** Does in-courtroom "second service" violate the traditional rule that parties, lawyers, and witnesses are immune from service of process while attending court and for a reasonable time traveling to and returning from court?

4. **Process Immunity – State or Federal Law?:** Is the traditional rule of process immunity a matter of state law for individual states to define or is it a federal matter?

5. **Process Immunity – Governing Law In Federal Question Cases:** When a plaintiff – in a suit founded on a federal question and not on diversity, but in which the federal statute itself (here, the Lanham Trademark Act), in relevant part, does not authorize service other than in accordance with FED. R. CIV. P. 4(k)(1)(A), 4(e) and 4(f) – attempts to perform service under state procedures "borrowed" by FED. R. CIV. P. 4(k)(1)(A) and 4(e)(1), is process immunity governed by state or federal law?

6. **Process Immunity – Voluntariness Exception?:** If Massachusetts rejects a "voluntariness" exception to process immunity, such that parties, lawyers, and witnesses on court business are immune "whether they attend on summons or voluntarily, and whether they have or have not obtained a writ of protection," did the First Circuit err by predicating jurisdiction upon a defendant's "[voluntary] [entry] into Massachusetts" (emphasis in original)?

7. **Process Immunity – "Same Case" Exception?:** If Massachusetts never has recognized a "same or related case" exception to process immunity, then does *Lamb v. Schmitt*, 285 U.S. 222 (1932) (Mississippi case), impose a "same case" exception on Massachusetts, requiring defendants to seek a protective order to attend a hearing, and imposing "a relatively heavy presumption" against such orders even if sought?

8. **Process Immunity – "Same Case" Retroactivity:** Was the First Circuit's retroactive application of this "same case" exception, without advance notice of the change, in error?

9. **Process Immunity – "Protective Order" Exception?:** If Massachusetts rejects a "protective order" exception to process immunity, and parties on court business are immune "whether they attend on summons or voluntarily, and whether they have or have not obtained a writ of protection," then did the First Circuit err by stripping a defendant of the defense of lack of personal jurisdiction for failing to obtain a advance permission to participate in an hearing on this very defense?

10. **Process Immunity – Protective Order Rule Retroactivity:** Did the First Circuit err by reversing prior law retroactively, and applying the new "protective order" rule without fair notice or warning of the change?

11. **Process Immunity – Split Between First and Second Circuits:** The Second Circuit, e.g., *Shapiro & Son Curtain Corp. v. Glass*, 348 F.2d 460 (2nd Cir. 1965), and other Federal courts interpreting *Lamb v. Schmitt*, have concluded that *Lamb* does not establish the blanket exception the First Circuit claims it does. Because the First Circuit created a circuit split, see 236 F.3d at 62 n.9 (App, *infra*, 10a n.9), by rejecting the Second Circuit's view, how will this Court resolve the circuit split?

12. **Internet Due Process -- Website Visibility:** When an Internet Website publisher hosts that site on a "server" computer outside the United States, does the visibility of Website content from plaintiff's preferred jurisdiction (just as the same content is visible everywhere else in the world) supply sufficient jurisdictional contacts with the forum, or would jurisdiction over the publisher offend due process?

13. **Internet Due Process – Passive / Active "Sliding Scale:"** If a Website publisher's content is hosted on a foreign "server," are the requirements of due process satisfied if the trial court, on the basis of Website content (presumably, visible everywhere) characterizes the site as "not merely a passive one" – as opposed, evidently, to a "perfectly passive" Website?

14. **Internet Due Process – Split Among Circuits:** If Website "content" is proffered as a basis for jurisdiction, do traditional due process standards govern, as was held in *GTE New Media Servs. v. Bellsouth Corp.*, 199 F.3d 1343, 1349-50 (D.C. Cir. 2000); see also *Bensusan Restaurant Corp. v. King*, 126 F.3d 25 (2nd Cir. 1997), or should courts follow the novel "sliding scale" approach favored by the Fifth and Tenth circuits, see *Mink v. AAAA Development LLC*, 190 F.3d 333 (5th Cir. 1999); *Soma Medical Intern. v. Standard Cht'd Bank*, 196 F.3d 1292 (10th Cir.1999), or does some other standard govern?

15. **Due Process – Injunction Against Foreign Defendant:** Did assertion in this case of content control over a Website published abroad, by enjoining the persons of its Canadian publishers, violate the Due Process Clauses of the Constitution?

16. **Scope of Injunction – Equitable Balancing Rule:** If a trial court considers three design elements of a Website "homepage" potentially objectionable – and it is presented with concrete, less-restrictive alternatives to its preliminary injunction (each fully satisfying all its stated concerns) – seven, six, and three months, respectively, prior to the March 31, 2000 decision (appealable under 28 U.S.C. § 1292(a)(1)) granting, continuing and/or refusing to dissolve or modify the injunction – then does the injunction violate common-law and equitable standards requiring a close fit between the purpose and terms of any injunction, because the injunction (1) unnecessarily assumes complete content control over the homepage, (2) blacks out all content previously appearing there, and (3) dictates the entire substantive content that the publishers unwillingly must publish and subsidize?

17. **Scope of Injunction – "Forced Speech" First Amendment Violation:** If the trial court's March 31, 2000 decision to impose (or to refuse to modify) an injunction dictates the entire substantive content of the Website "homepage," then does it violate the prohibition against "forced speech" set forth in such cases as *Wooley v. Maynard*, 430 U.S. 705, 714 (1977), and *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995)?

18. **Scope of Injunction – "Strict Scrutiny" of Content-Based Speech Restrictions:** If an injunction unnecessarily (despite less-restrictive alternatives) assumes content control over a Website "homepage" and dictates its entire substantive content, then does the injunction violate the rule of *Perry*

Education Assn. v. Perry Local Educators' Assn., 460 U.S. 37, 45 (1983), *Simon & Schuster, Inc. v. Crime Victims Bd. of New York*, 502 U.S. 105, 115-18 (1992), and other cases, that content-based speech restrictions must be narrowly drawn and necessary and to serve a compelling state interest?

19. **Scope of Injunction – Heightened Scrutiny of Speech-Regulating Injunctions:** If an injunction unnecessarily (despite known alternatives) dictates the entire substantive content of a Website "homepage," then does it violate the rule of *Madsen v. Women's Health Ctr., Inc.*, 512 U.S. 753 (1994), that all injunctions (even content-neutral ones that only incidentally burden speech) must "burden no more speech than necessary to serve a significant government interest?"

20. **Scope of Injunction – Failure of Appellate Court to Exercise Supervision Over Preliminary Injunction Despite Proper 28 U.S.C. § 1292(a)(1) Appeal:** If challenges to the imposition and scope of a preliminary injunction are the very reason for an interlocutory appeal under 28 U.S.C. § 1292(a)(1), and the appeals court acknowledges these issues "have been raised below," such that "we do not find waiver," and it does "not preclud[e] further consideration" at trial, then should the court correct the continuing daily violation of the defendants' First Amendment and general equitable rights, or may it fail to correct error by remanding with instructions that issues "can be argued in the trial on the merits?"

21. **Anticybersquatting Consumer Protection Act "Objective Reasonableness" Defense – Statutory Interpretation:** In light of the alternatives: e.g., (1) one resembling the "objective reasonableness" defense in qualified immunity cases such as *Anderson v. Creighton*, 483 U.S. 635 (1987), or (2) a burden-shifting framework as in *McDonnell-Douglas Corp. v. Green*, 411 U.S. 792 (1973), or (3) by

reference to state law "bad faith" insurance torts, or (4) some other legal framework – how should the "objective reasonableness" defense established in 15 U.S.C. § 1125(d)(1)(b)(ii), as a legal matter, be interpreted and applied?

22. **ACPA "Objective Reasonableness" – Method of Raising Defense:** Have the courts below misapplied the "objective reasonableness" defense by denying the very existence of defendants' subjective beliefs instead of considering whether those beliefs are objectively reasonable?

23. **ACPA – Failure to Address Changed Circumstances When Predicating Injunction On ACPA Violation:** Did the trial court and the First Circuit err by attempting to apply the ACPA to factual circumstances that had ceased to exist more than three months before the ACPA was signed into law, instead of predicating their injunction analysis on facts as they existed at the time of the trial court's March 31, 2000 decision?

24. **Injunctive Relief -- Changed Circumstances:** Did the First Circuit err by failing to dissolve or modify an injunction issued by the trial court on March 31, 2000, based on the assumption that nothing had changed in the time between September 1, 1999, and March 31, 2000, thereby freezing matters "at the time of commencement of the action" instead of considering changes during the intervening seven months?

Parties to Proceeding

641271 Alberta, Ltd., d/b/a Northern Lights Club – A Canadian corporation[1] headquartered in High Prairie, Alberta, Canada, whose stock is not traded on any public exchange. 641271 Alberta, Ltd., has no corporate parent and therefore no shares are traded on any public exchange.

Mr. Jeffrey K. Burgar – A natural person residing in High Prairie, Alberta, Canada.

Northern Light Technology, Inc. – A corporation headquartered in Cambridge, Massachusetts, whose stock is not traded on any public exchange. On or about September 11, 2000, counsel for Northern Light Technology ("NLT") certified to the court of appeals that NLT is a private corporation without any corporate parent and that no public companies own 10% or more of NLT's stock. Petitioners have no reason to believe these facts have changed since September 11, 2000.

Northern Lights Club – A d/b/a of 641271 Alberta, originally adopted to simplify Network Solutions, Inc. ("NSI") renewal billing. Among other reasons,[2] bills addressed to "[Name] Club" signify through the envelope addressing window which bills have come due. This convention also facilitates certain functions that NSI's billing system, at one time, could not handle without a unique registrant for each Domain Name.

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[1]Because of certain aspects of Canadian corporation law, the vast majority of Canadian corporations are uniquely numbered.

[2]The origins and function of the "[Name] Club" naming convention appear to have generated misunderstanding by the courts below – which these courts had every opportunity to avoid and did not. Accordingly, we elaborate on these matters briefly in the Statement of the Case, p.14, below.

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IN THE

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NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

PETITION FOR WRIT OF CERTIORARI

Petitioners Jeffrey K. Burgar and 641271 Alberta, Ltd., d/b/a Northern Lights Club, respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the First Circuit in this case.

Opinions and Orders Below

The opinion of the court of appeals (App., *infra*, 1a-19a) is reported at 236 F.3d 57. The order of the court of appeals denying Appellants' petition for rehearing and suggestion for rehearing *en banc* (App., *infra*, 20a) is unpublished. The opinion of the district court dated March 31, 2000 (App., *infra*, 41a-90a), is reported at 97 F. Supp. 2d 96.

Other opinions, orders, and hearing transcripts potentially relevant to the resolution of this case are unreported. Full citations (and, where applicable, appeals court Joint Appendix references) for each of these documents may be found in the

margin.[3]

Basis for Jurisdiction

The basis for review by writ of certiorari to the United States Court of Appeals for the First Circuit is 28 U.S.C. § 1254. The date of the judgment of the United States Court of Appeals for the First Circuit was January 8, 2001. The date of entry of the order denying Appellants' Petition for Rehearing and Suggestion for Rehearing *En Banc* was January 30, 2001. The Court of Appeals had jurisdiction under 28 U.S.C. § 1292(a)(1) because the appeal was from a March 31, 2000 interlocutory Order of the United States District Court for the District of Massachusetts, granting, continuing, modifying, refusing or dissolving or refusing to dissolve or modify a preliminary injunction. The trial court's subject-matter jurisdiction was based on 28 U.S.C. §§ 1331 and 1338(a), because the plaintiff asserted claims arising under a United States statute – namely, the Lanham Trademark Act (as amended). No notifications under Rule 29.4(b) or (c) are believed to be necessary.

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[3] *Northern Light Technology, Inc. v. Northern Lights Club*, No. 00-1641, 236 F.3d 57, 57 U.S.P.Q.2d 1277 (1st Cir. 2001).

Order Denying Petition for Rehearing and Suggestion For Rehearing *En Banc*, *in Northern Light Technology, Inc. v. Northern Lights Club*, No. 00-1641 (1st Cir. Jan. 30, 2001).

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Transcript of Hearing (Jan. 21, 2001) (Dkt. No. 99) (C.A. J. App. 436-513), *in* [*NLT*], No. 99-11664 (D. Mass. *filed* Aug. 5, 1999).

Constitutional Amendments, Statutes and Rules Involved

The First Amendment to the United States Constitution provides, in relevant part, "Congress shall make no law . . . abridging the freedom of speech or of the press." U.S. CONST. amend. 1

The Fifth Amendment to the Constitution provides, in relevant part, "No person shall . . . be deprived of life, liberty, or property, without due process of law . . . ." U.S. CONST. amend. 5

The Fourteenth Amendment provides, in relevant part, "No State shall . . . deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws." U.S. CONST. amend. 14, § 1.

The Anticybersquatting Consumer Protection Act of 1999 provides, in relevant part, "(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful." 15 U.S.C. § 1125(d)(1)(B)(ii).[4]

28 U.S.C. § 1292 provides, in relevant part, "(a) . . . [T]he courts of appeals shall have jurisdiction of appeals from: (1) Interlocutory orders of the district courts of the United States . . . or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court . . . ."

The Rules of Decision Act provides, in relevant part, "The laws of the several states, except where the Constitution or treaties of the United States or Acts of Congress otherwise require or provide, shall be regarded as the rules of decision in civil actions in the courts of the United States, in cases where

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[4]The full text of 15 U.S.C. § 1125, as amended is set forth in the Appendix. (App., *infra*, 21a - 29a).

they apply." 28 U.S.C. § 1652.

Rule 4 of the Federal Rules of Civil Procedure,[5] in relevant part, provides:

> **Fed. R. Civ. P. 4. Summons.**[6] . . .
>
> (e) **Service Upon Individuals Within a Judicial District of the United States.** Unless otherwise provided by federal law, service upon an individual from whom waiver has not been obtained and filed, other than an infant or incompetent person, may be effected in any judicial district of the United States:
>
> (1) pursuant to the law of the state in which the district court is located, or in which service is effected, for the service of summons upon the defendant in an action brought in the courts of general jurisdiction of the State; . . .
>
> (k) **Territorial Limits of Effective Service.** (1) Service of a summons or filing of a waiver of service is effective to establish jurisdiction over the person of a defendant
>
> (A) who could be subjected to the jurisdiction of a court of general jurisdiction in the state in which the district court is located . . .

FED. R. CIV. P. 4(e)(1), 4(k)(1)(A).

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[5]The full text is set forth in the Appendix. (App., *infra*, at 30a - 40a).

[6]**Notes of Advisory Committee on 1993 Amendments:** . . . .

Note to subdivision (e). This subdivision replaces former subdivisions (c)(2)(C)(1) and (d)(1). It provides a means for service of summons on individuals within a judicial district of the United States. Together with subdivision (f), it provides for service upon persons anywhere, subject to constitutional and statutory constraints.

Service of summons under this subdivision does not conclusively establish jurisdiction of the court over the person of the defendant. A defendant may assert the territorial limits of the court's reach set forth in subdivision (k), including the constitutional limitations that may be imposed by the Due Process Clause of the Fifth Amendment. . . .

FED. R. CIV. P. 4(e) advisory committee's 1993 note.

Statement of the Case[7]

Companies sometimes have personalities. Northern Light Technology ("NLT") does. NLT attempts to differentiate itself from better-known, more useful search engines[8] with the promise (presumably seductive to certain kinds of people) to "organize, categorize, and systematize" the diverse and multitudinous information on the global Internet, into "neat little blue folders."[9] This invites two obvious questions:

(1) Can the Internet – with content "as diverse as human thought"[10] – be shoehorned into "neat little blue folders?," and

(2) Does it want to be stuffed into "little blue folders?"

As this Court recognized in the heady days of 1997, when the

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[7]The trial court's subject-matter jurisdiction was predicated on 28 U.S.C. §§ 1331 and 1338(a), because the plaintiff asserted claims arising under a United States statute – namely, the Lanham Trademark Act (as amended).

[8]The concept of a "search engine" is discussed in *Reno v. American Civil Liberties Union*, 521 U.S. 844, 852 (1997) ("*Reno*"). There exist perhaps several dozen competitors in the "search engine" business – all purporting to provide searchable databases of all or most of the content on the Internet (with varying degrees of completeness). The leading search engine today is probably Google, although Yahoo! (technically, an "Index") probably is best-known. Unlike Yahoo!, Google, and Alta-Vista, which have high brand recognition, NLT has abysmal recognition. It is also important to contrast localized, or "site search" functions. Literally millions of different Websites offer localized "site search" capabilities – which are limited in scope to a much tinier sliver of Internet content. Because "site search" boxes are ubiquitous, the difference between "search engines" and "site search" boxes is widely understood and appreciated in Internet circles – even among users who have been "connected" only a couple of weeks.

[9]See USPTO Trademark Application No. 75358047 (*filed* Apr. 26, 1999) (DEAD) ("CUSTOM SEARCH FOLDERS"); see also USPTO Trademark Application No. 76041419 (*filed* May 2, 2000) ("NORTHERN LIGHT" for "Computer . . . search engines . . . which grou[p] search results into folders . . . with similar subjects, sources, or types").

[10]*Reno*, 521 U.S. at 852, 870.

Internet Boom was exploding full force, the Internet is "a unique and wholly new medium of worldwide human communication" that "enable[s] tens of millions of people to communicate with one another and to access vast amounts of information . . . ." *Reno*, at 850.

"Anyone . . . may take advantage of a wide variety of communication and information retrieval methods. These methods are constantly evolving and difficult to categorize precisely." Id. at 851. However, email and the World Wide Web are by now familiar.[11] Id. at 851-52. "Taken together, these tools constitute a unique medium – known to its users as 'cyberspace' – located in no particular geographical location but available to anyone, anywhere . . . ." Id. at 852.

The Internet is the "Marketplace of Ideas" on steroids. "[A]t any given time, '[hundreds] of thousands of users are engaging in conversations on a huge range of subjects.'" Id. "Any person or organization with a computer connected to the Internet can 'publish' information. Publishers include government agencies, educational institutions, commercial entities, advocacy groups, and individuals." Id. at 853. "This dynamic, multifaceted category of communication includes not only traditional print and news services, but also audio, video, and still images, as well as interactive, real-time dialogue. Through the use of chat

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[11]Judge Stahl's oversimplification and seeming belief and that Domain Names have no other function than email and the 'Web (see App., *infra*, at 3a n.1), however, is incorrect. Several other statements by the courts below – such as speculative talk about so-called "'entice[ment]' of users to post material" (see App., *infra*, at 7a (citing 97 F. Supp. 2d at 104-06), 57a, 59a) – also have no record support. Neither party ever suggested such a feat is possible – which only makes sense, because it isn't. Setting aside the trivial case of a computer "cracker" committing a felony by "breaking into" an unsecure Website server – ordinary Website visitors cannot (usually, even "crackers" cannot) post advertisements, links, or any other content. The opinions below also reflect some lack of appreciation (even though fairly detailed explanation was provided) of how advertising works on the Internet.

rooms, any person with a phone line can become a town crier . . . . Through the use of Web pages, mail exploders, and newsgroups, the same individual can become a pamphleteer. . . . '[T]he content on the Internet is as diverse as human thought.'" Id. at 870.

Given NLT's evident focus on control (stuffing the Internet into blue folders) it should hardly be surprising that NLT wants to control the speech of others – using the courts, if possible, as a mechanism for content control. In this case, what NLT seeks to control is a Website belonging to somebody else.

The publishers of the www.NorthernLights.com Website – which was launched first and was in active use for almost a year prior to the NLT search engine – evidently rub the CEO of NLT the wrong way. NLT (the latecomer) wants to own (and control the content of) both Websites, rather than co-existing and learning to live with the Internet's diversity of expression. If NLT really meant to co-exist peacefully, then it would have resolved this case in July, 1999, when Defendants made overtures to do so. Defendants were willing – as their counsel told NLT (the trial court was also told repeatedly) – to compromise by removing the localized "site search" box that NLT has decried so vociferously.[12] Defendants also offered to

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[12]Nevertheless, the trial court piles blame upon Defendants for the notion that they "made little or no effort to curtail their allegedly infringing activity." *See* App., *infra*, 55a. But the Defendants did offer to modify the Website, if that would resolve the dispute. The Plaintiff is the party that has consistently blocked all progress. (Defendants' pre-litigation overtures to open discussions about compromise are in the record). NLT has repeatedly (even prior to the lawsuit) rejected any outcome other than outright transfer of control. Thus – since NLT consistently refused to negotiate – it is NLT that bears sole blame for the posture of the case at the September 1, 1999 hearing. Moreover, at the Sept. 1, 1999 hearing, Defendants volunteered unilaterally to add a disclaimer and to remove both "allegedly infringing" elements from the site – the "search box," and the hyperlink. The Defendants also made these changes unilaterally. Only NLT has made "no effort."

change the content back to its pre- April 4, 1999 state. The only party blocking resolution and compromise has been NLT, which continues to insist on forcing a sale – even though Defendants do not want to sell. In reality, all this nonsense about a "search box" and a hyperlink is pure pretext: NLT's agenda is complete domination, not reasonable compromise.[13]

NLT admits it has coveted[14] the Domain Name NorthernLights.com since July 1996. Not only did NLT attempt to negotiate the purchase of NorthernLights.com in March 1999 – after USA Today spelled NLT's name wrong,

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[13]Notably, NLT's attitude about its own purported "intellectual property" rights differs markedly from its position concerning the IP rights of others. NLT has been sued in several cases by freelance writers – most of which have been consolidated in the Southern District of New York. While the cases raise some issues similar to *Tasini v. New York Times Co.*, 206 F.3d 161 (2d Cir. 2000), *cert. granted*, 121 S. Ct. 425 (2000), the Northern Light case is even more egregious than *Tasini* because NLT collects pay-per-copy fees when it republishes so-called "Special Collection" documents. NLT collects these fees on a per-document basis – without sharing any revenue with copyright-owning freelance writers – when NLT (sometimes knowingly) sells unauthorized copies of writers' works.

[14]The reason for coveting this name is simple – serendipity. Users who type addresses this navigation method works when returning to Websites (bookmarks work better), but it is haphazard at best when venturing into and exploring new territory. In fact, most know only to expect surprises – for nobody entirely can predict what will be found at any previously un-visited address. But this haphazard quality of stumbling upon the unexpected – the serendipity of discovery – is exactly what makes this method of navigation so attractive. NorthernLights.com is the kind of domain name that a lot of people type, expecting to be surprised.

NLT's revenue stream is principally a function of "hits" or "eyeballs" – and the more new visitors that stumble across the NLT website, then the more regular customers NLT ultimately hopes to win. (Presumably, any repeat visitors who type an "s" by mistake recognize and correct the mistake instantly and with ease.) Since NorthernLights.com generates "serendipity" traffic, NLT views it as a rich source of potential new customers to be introduced for the first time to NLT's services.

but NLT also sought to buy it in June, 1996[15] (even before any of the Defendants registered NorthernLights.com). Mr. David Seuss, NLT's CEO has testified that he called the registrant for this domain name (necessarily a prior registrant)[16] about a purchase inquiry in 1996. Evidently, NLT did not acquire the name because the prior registration lapsed sometime in October, 1996, and Defendant 641271 Alberta Ltd., registered NorthernLights.com on October 31, 1996.

The NorthernLights.com Website was activated in November, 1996 – about five months prior to the argument in *Reno v. ACLU*. It was not until August 1997 – about three months after the *Reno* opinion was issued – that the NLT "re"search engine opened for business. In short, Defendants certainly were unaware of Plaintiff and its search engine at the time NorthernLights.com was registered.

From November 1996 continuously through April 4, 1999, the NorthernLights.com Website was active and consisted of the identical Website "homepage" as < www.FlairMail.com >, because FlairMail was the licensee of this domain name (and

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[15]NLT Employee Charles Snow confirms that Mr. Seuss did not, in fact, talk to Mr. Burgar, but instead with a prior registrant located in New York.

[16]Importantly, that prior registrant is not a party to this lawsuit and any statements allegedly made by that stranger cannot be attributed to anyone in this lawsuit. See 94 F. Supp. 2d at 102 n.9 (App., *infra*, at 50a). Defendant 641271 Alberta, Ltd. d/b/a Northern Lights Club was the third registrant, historically, for this name. Given Judge Woodlock's footnote 9, his subsequent reliance on Seuss's testimony as evidence of and Defendant's "bad faith intent" in this case simply defies reasoned analysis. See App, *infra*, 84a. The trial court's reference to a settlement letter (App., *infra*, at 85a) is also wrong. As Judge Woodlock clearly knows (but has omitted), the face of this particular letter clearly says the Defendants were disinclined to sell at any price, but in response to an inquiry initiated by the Plaintiff, would not foreclose this avenue of negotiation. However, Defendants refuse to be browbeaten into a forced sale.

several others),[17] and because this arrangement made it easier for new [myname]@NorthernLights.com vanity email subscribers, to locate the sign-up page, as well as for existing subscribers to access their accounts.

The Domain Name < NorthernLights.com > was registered for precisely the same reasons as < AbominableSnowman.com >, < LochNessMonster.com >, and a number of other "catchy" domain names:[18] (1) these are good addresses to offer for free email subscribers, and (2) over the long run, they may be good addresses to construct different Websites. If one wants to build a Website using such an address, one cannot wait to register. Under the first-come-first-served rule of Domain Name allocation, somebody else will register it long before you do.

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[17] E.g., [myname]@skifan.com, sbrever@northernlights.com, nscalia@chooselife.com, wrehnquist@booklover.com, or gbush@theovaloffice.com. 641271 Alberta, Ltd., licenses a some of these Domain Names to a separate company called FlairMail, that provides personalized "vanity" email addresses for subscribers.

[18] Contrary to certain language in the First Circuit's opinion (seeking to redefine "catchy" in a peculiar way), "catchy" names are specifically selected not to reflect any trademarks. Examples of "catchy" domain names include: artlovers.com, camera-expert.com, booklover.com, movielovers.com, aquarius1.com, scorpio1.com, baseballcrazy.com, golfcrazy.com, duffers.com, ottawa1.com, texas1.com, chooselife.com, countrygal.com, redhot1.com, and hermajesty.com. They involve no trademarks, but may be attractive for vanity email addresses, or – over the longer term – may be interesting Website "locations." Granted, in some "fair use" categories, see note 22, *infra* – 641271 Alberta or other entities have registered a limited number of domain names that reflect or incorporate trademarks. For example, a handful of registrations were done by or on behalf of authorized dealers of merchandise (e.g., Mr. Burgar's daughter is authorized to sell Hewlett-Packard printers at her bookstore and HP, from 1985 through 1996, used only < HP.com > and no other address). See *Weber-Stephen Prods. Co. v. Armitage Hardware Co.*, D2000-0187 (WIPO May 11, 2000). However, Mr. Burgar could, in 1996 – if he were really following the "script" posited by Judge Stahl – have registered thousands of trademark-identical Domain Names. He specifically chose **not** to do so.

Nevertheless, the First Circuit's opinion, dripping with condescension, labels Mr. Burgar[19] a "self-described" Internet entrepreneur – as if to suggest he isn't really an Internet Entrepreneur. In reality, he is an Internet entrepreneur. Mr. Burgar is one of the original four investors in Internet North – an internet service provider ("ISP") – as well as the man in charge of its day-to-day operations. This company, very early on, brought dial-up Internet access to a large part of central and northern Alberta. Mr. Burgar also has a Website design firm, a consultancy business,[20] and several other, separate Internet-related businesses. In short, he is one of the visionaries who contributed (at least in a modest way) toward building out the infrastructure and fueling the explosion of diverse expression that flourished between approximately 1993 (when Tim Berners-Lee released the protocols for the World-Wide Web to the world without charging any royalties) and sometime in 1999 or early 2000, when things started changing considerably.

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[19]Jeffrey K. Burgar is a newspaperman by trade and manages several newspapers in northern Alberta. An elected public official in his hometown of High Prairie, he is a pillar of his community. In addition to Internet ventures, Mr. Burgar has also been involved as an investor or a manager of several other enterprises – cable television, a computer store, a tavern, and an automobile dealership, among other projects. He and his wife have two children – one a grown adult and the other in elementary school.

[20]For example, Mr. Burgar is an independent consultant for Nova-Scotia based < www.CanSell.com >, a classified advertising site that is not a party to this litigation in any way. It just so happens that Mr. Burgar – when he declined to sell NorthernLights.com to NLT, also informally probed on behalf of CanSell (and not any Defendant) about the availability of a software license. The licensing inquiry was promptly rejected. Therefore, the licensing inquiry is no basis for Massachusetts jurisdiction. "My company" to which Mr. Burgar refers, when misquoted by Judge Woodlock (App., *infra*, 56a) is unambiguously CanSell, and not any other entity – certainly **not** NorthernLights.com (despite Judge Woodlock's effort to conflate the two). Accordingly, this quotation cannot possibly serve as any basis for Massachusetts jurisdiction.

Defendants respectfully disagree with the First Circuit's effort to redefine the "catchy" subcategory of domain names,[21] as something else entirely. The contention that "catchy" means "i.e., Internet addresses appropriating, in identical or slightly modified form, the names of popular people or organizations," (App., *infra*, 3a, 16a), is roughly akin to arguing that the population of Boston is – *by definition* – comprised entirely of the physically handicapped, based only upon the observation one day of three or four persons in wheelchairs (out of hundreds encountered). Although no domain names "appropriate" anything, it is true that a small handful[22] of addresses (e.g.

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[21]This "catchy" or "generic" category of domain names (NorthernLights.com is clearly in this category) – is not about trademarks. Ownership by 641271 Alberta, Ltd., of a fair number Domain Names is no more blameworthy than Procter and Gamble's project of "warehousing" catchy domain names (although P&G probably has secured a much larger number). P&G has thousands of domain names such as sinus.com, thirst.com, and flu.com. Moreover, P&G has not put most of them to use. Recently, it has sought to arbitrage several for a profit. Mr. Burgar, in contrast, has worked hard to avoid arbitrage and has actually put "generic" domain names such as LochnessMonster.com, AbominableSnowman.com, and NorthernLights.com, to constructive use by sharing them for free with others.

[22]Separately, either 641271 Alberta, Ltd., or one or more other corporations (all formalities are properly observed) have independently registered some domain names in categories other than "generic" or "catchy" that (at least as things stood in 1996) were evaluated in reference to traditional principles of "fair use." For example, a separate corporation (not 641271 Alberta) is the registrant for about 40 names corresponding with individual celebrities, which have carefully been used in a manner consistent with established fair use principles. See New Kids on the Block v. News Am. Publishing, 971 F.2d 302 (9th Cir. 1992); Springsteen v. Burgar, No. 2000-1532 (WIPO Jan. 25, 2001),<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html >. Extraordinary effort has been made not to infringe any trademark. The sports names (the case involving these has already been settled) were used with great care to remain clearly within the fair use (continued...)

about 40 "celebrity" names[23] belonging to a corporation other than 641271) – compared with roughly 2000 of the generic golflover / bassangler / booklover variety – do have a trademark-referential aspect to them. However, overemphasis on a few names, without attention to the overall picture, combined with inattention to issues such as fair use, is hardly a methodology for presenting a fair and unbiased assessment of the facts.

Finally, Judge Stahl's hypothesis that the "[Name] Club" convention involved some nefarious scheme to "present a mantle of legitimacy in their registration requests to NSI," (App., *infra*, 15a), is preposterous. There can hardly be a need to "fool" a gatekeeper, when nobody is serving any such "gatekeeping" function. Even at present, NSI pays no attention

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[22](...continued)
doctrine. See, e.g., Mark A. Lemley, *The Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1696, 1706-09 (1999). Nevertheless, principle can be expensive. The sports teams have used litigation to drive several free services (not just FlairMail, but several dozen companies) out of the marketplace. Now, fans must pay monopoly rents for the same services. Consumer protection? We think not. Transfer of the sports names has been bad for customers and fans.

[23]Considerable effort has gone into developing content – including expressive opportunities – for fans, in connection with a small collection of "celebrity" names. See < http://www.celebrity1000.com/celebritysites/ >. Such an investment of time and money is hardly the "modus operandi" of somebody interested in *arbitrage*, as opposed to preserving the important value of diversity on the Internet. In the past year, a surprising number of large entertainment companies have gone out of their way to monopolize ".com, .net, and .org" sets of domain names – which essentially prevents any other independent speaker (e.g., fans) from having anything resembling an equivalent opportunity to reach a potential audience. In short, the extraordinary thing about the Internet in 1996 was the leveling of the communications hierarchy of the past several decades, and a return to a less-centralized marketplace of ideas. The hierarchy is rapidly returning, however, with detrimental consequences for democratic free expression.

and registers everything (with the exception of a few "naughty words"). When the domain name registration system was set up, the process of providing addresses was entirely about billing – not law enforcement, not trademarks, not enabling criminals to stalk people who publish their personal addresses, and not service of process. It was about enabling NSI to collect as much money in renewal fees as possible. Period.

And, consistent with this billing function, and standards that applied in 1996, there is a real benefit to having a U.S. (as opposed to Canadian) mailing address – renewal bills are more likely to arrive without getting lost or returned for lack of postage – preventing cancellation of names for failure to pay for renewal. Moreover, the "[Name] Club" convention has the added benefit of facilitating renewal payments because the names of billing addressees clearly identify which names require renewal. Finally, a temporary software problem with NSI's billing systems made it preferable for record-keeping purposes to register each Domain Name under a unique registrant. Moreover, in this case, when Plaintiff NLT asked **who** the actual legal entity was that owned NorthernLights.com, NLT was given both a street address for service of process and the truthful and correct of the legal owner less than 24 hours after the inquiry was made. Hardly the nefarious "script" Judge Stahl seems to suggest.

Proceedings Below: The posture of this case is somewhat unusual because of the approach the First Circuit took in attempting to dispose of the appeal. The appeal was under 28 U.S.C. § 1292(a)(1), from a March 31, 2000 preliminary injunction order entered by the trial court. The appeal presented three main grounds for reversing the preliminary injunction: (1) the trial court lacked jurisdiction to enjoin the persons of the defendants, (2) the injunction was excessive in scope – **both** due to the traditional balancing done for all injunctions **and** because the injunction clearly violated the First Amendment by imposing too-severe content-based

restrictions on speech, and (3) as a legal matter, the trial court misinterpreted and misapplied the ACPA.

The court of appeals, with great care, saw fit to chart a course designed to avoid addressing **any** of the issues raised on appeal. Instead, it took up some tangential issues interjected by the Appellee's Brief.[24]

The appeals court was evidently less than enamored with the trial court's jurisdiction theory: "Based on this determination we need not reach the alternate bases for personal jurisdiction discussed in the district court's opinion." (App., *infra*, 13a). Instead, it elected to abandon the trial court's theory altogether in favor of a theory based on by in-courtroom service of a second summons on January 19, 2000.

By failing to address important issues (treated at length in the trial court's decision) concerning what the First Circuit described as "the convoluted issues of personal jurisdiction arising from Internet activities," (App., *infra*, 6a) the appeals court essentially used its jurisdictional switcheroo as a vehicle for attempting to dodge questions both about serious defects in the content-forcing injunction entered by the trial court and the split among circuits concerning "Website jurisdiction."

Interestingly enough, the First Circuit did not even bother to get its dates right. The return of service (incidentally, the record contains only one return of service, for one defendant, not three returns see FED. R. CIV. P. 4(b)) was included in the

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[24]The district court expressly declined to consider the validity of personal jurisdiction based on physical service of process. App., *infra*, 61a n.12. "On appeal, however," the First Circuit observed, "plaintiff continues to press its case that, under the doctrine of transient jurisdiction, it has satisfactorily created jurisdiction through its service of process on Burgar prior to the September 1, 1999 hearing." (App, *infra*, 9a).

Appendix[25] and clearly bore the date of January 19, 2000. Nevertheless, the court of appeals repeatedly insists (for some unknown reason) that September 1, 1999 was the special day. See App., *infra*, 5a ("Moments before the district court hearing on September 1, 1999 . . ."), 9a ("just prior to the September 1, 1999 [temporary restraining order] hearing").

While Mr. Burgar was present in the courtroom, prior to the January 19 jurisdiction hearing, and while the judge was on the bench, counsel for the Plaintiff purported to serve a second summons on him. Mr. Burgar had already been served with summons – on August 13, 1999. The original service took place in High Prairie, Alberta, Canada. Mr. Burgar responded to the first summons on August 20, 1999, by filing a timely and proper FED. R. CIV. P. 12(b)(2) personal jurisdiction motion (and other motions) – which personal jurisdiction motion (and supplemental briefing by both parties) was the explicit subject of the January 19 hearing. The trial court on its own morion had noticed the hearing in an order dated November 18, 1999.

Plaintiff's counsel claimed the second summons had been performed in "an abundance of caution," but Judge Woodlock saw things differently: "Efflorescence of chutzpah . . . is probably closer to it." He also remarked: "That doesn't confer jurisdiction; just because you've show[n] up for a hearing." The trial court evidently did not have much faith in the theory that the court of appeals relied upon exclusively as a basis for jurisdiction. The trial court specifically declined to address the issue of in-courtroom service. App., *infra*, 61a n.12.

Prior to January 19, 2000, Jeffrey K. Burgar, a life-long resident of Alberta, Canada, had never previously set foot in Massachusetts. His visit had exactly one purpose – to assert the defense of lack of personal jurisdiction in pending litigation. Mr. Burgar was not present in Massachusetts on a whim. If his

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[25]Pages 400-01 of the Joint Appendix reproduced verbatim the handwritten purported "return of service," which was dated January 19, 1999.

entire purpose was to challenge jurisdiction, his presence certainly cannot constitute "purposeful availment."

Mr. Burgar – both a party and a material witness – had every right to attend a hearing at which his own rights were being adjudicated. It was also clear – and specifically communicated – to the trial court that Mr. Burgar had been present that day to make himself available as a fact witness. There is no dispute that Mr. Burgar's testimony would have been helpful to the trial court because the trial court made some serious mistakes in its Opinion issued on March 31, 2000.

The First Circuit's Failure to Address The Preliminary Injunction "Balancing" and First Amendment Violations: Essentially, the Court of Appeals used the issue of "transient jurisdiction" as a vehicle to bypass and ignore the entire contents of the Defendants-Appellants' Opening Brief. As a result, the trial court's injunction – which unnecessarily forces Defendants to speak content of the plaintiff's choosing – has arbitrarily been left in place.

The whole purpose of permitting interlocutory appeals from injunctions under section 1292 is to make sure that prompt and effective relief is available at the appellate level. The ruling in this case (leaving the injunction in place pending trial) completely subverts this important function.

The appeals court attempts to justify its result by pointing to an "obliqu[e] refer[ence]" at "the critical hearing" – which the appeals court seems to believe was the afternoon hearing on September 1, 1999. However, the order **appealed from** was dated March 31, 2000. In the Order, the trial court specifically ruled on a motion timely filed in mid-September by Defendants,[26] in which First Amendment issues were

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[26]Mr. Burgar's counsel also had previously sought, on November 18, 1999 (on the basis of a lengthy motion filed well in advance of the November hearing), to expedite the dissolution of the trial court's restraining order.

(continued...)

extensively briefed. The trial court had seven months to ponder the First Amendment, with ample briefing by both sides.

The thrust of Defendants' argument is a simple one. The trial court identified three things to change – (1) removal of a "search box," (2) removal of a hyperlink, and (3) posting of a disclaimer. Thus, a narrowly-tailored injunction would have ordered these three things to prevent "confusion," and would have left Defendants otherwise free to express themselves.

Instead, the trial court imposed an unnecessarily severe inunction that commandeered and blacked out the Defendants' **entire** homepage, and replaced it with the text that the Plaintiff had insisted be published there (the Plaintiff's design was essentially a pretext to increase Plaintiff's advertising revenue by cannibalizing as much traffic as possible and diverting it onto Plaintiff's Website). The injunction was emphatically not "narrowly tailored" or the least restrictive means of accomplishing the trial court's objectives. It was calculated to marginalize the speech of the defendants as much as possible.

The trial court was presented with no fewer than **three** less-restrictive alternatives, each of which fully satisfied all of its identified criteria. Nevertheless, it completely failed to provide any rationale whatsoever for failing – on March 31, 2000 – to dissolve or modify its injunction.[27] By ducking this critical

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[26](...continued)
When counsel pressed the court for a ruling at the November hearing, the court first refused to rule – objecting to what it viewed as "an oral motion" (even though a paper motion had been on file for some time). When pressed further, the court left the paper motion for dissolution pending (and set it for a January hearing date), after "denying" the "oral motion" for dissolution.

[27]The trial court's balancing analysis (set forth in its entirety below) completely fails to address any less-restrictive alternatives:

The public interest . . . will best be served in the interim by a solution that
(continued...)

issue entirely, the court of appeals has subverted **the entire purpose** of 28 U.S.C. § 1292(a)(1).

Argument For Granting Certiorari

Overview: For over a decade, this Court has not issued a single opinion addressing personal jurisdiction. The last time the Court took up any issue of personal jurisdiction (specifically, the question of the effect, if any, of *Shaffer v. Heitner*, 433 U.S. 186 (1977), upon the doctrine of "transient jurisdiction"), in *Burnham v. Superior Ct. of Cal.*, 495 U.S. 604 (1990), its effort produced decidedly mixed results. No single point of view commanded a majority of the Court. Therefore, *Burnham*'s holding is confined to the facts of that case.

The Court should grant Certiorari in this case because it requires the Court to consider due process and personal jurisdiction with an eye to both the past and the future – by analyzing both transient jurisdiction (an opportunity to revisit and clarify *Burnham*) and the salient issue of long-arm "Website jurisdiction" in an Internet case. Moreover, in relation to transient jurisdiction, this case presents several important sub-issues of first impression relating to the traditional immunity of parties, lawyers and witnesses from service of process. The circuits are split on the scope of party-lawyer-witness immunity. This Court has not spoken to the subject of process immunity since prior to World War II.

Third, this Petition presents an important question concerning appellate supervision over trial court preliminary injunctions and the purpose of 28 U.S.C. § 1292(a)(1). In this

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[27](...continued)
diminishes the possibility of confusion but nevertheless permits the public access to Defendants' legitimate expression and services. . . . Based upon an evaluation of the several factors relevant to preliminary injunction analysis, I find that the interlocutory relief I have ordered shall remain in place for the remainder of this case.

App., *infra*, at 88a.

case, an appellate court has attempted (despite acknowledging that these issues were properly briefed, timely appealed, and were not waived) arbitrarily to dodge all issues on appeal concerning the scope of an injunction that obviously violates the speech and press rights of a publisher. The First Circuit has attempted to do so by simply remanding for "trial on the merits" without even discussing the daily injury that the content-forcing injunction does to the publishers' speech and press rights, and without even entertaining the possibility of an immediate modification to minimize continuing harm.

Finally, on top of the important and timely issues identified above, this case also presents a novel, important, and timely question of statutory interpretation – namely, what legal framework must courts, plaintiffs and defendants follow in cases under the Anticybersquatting Consumer Protection Act of 1999 ("ACPA"), to make sure that the good-faith "objective reasonableness" defense recognized by Congress is fairly and uniformly applied. If reasonable minds can differ about whether particular Internet-related activity is infringing or "is a fair use or otherwise lawful," then 15 U.S.C. § 1125(d)(2)(B)(ii) clearly says the Defendant gets the benefit of his or her reasonable good-faith subjective beliefs. This only makes sense, because the spirit of bold creativity and experimentation on the Internet – which is precisely what fed the Internet Boom back in 1997 – represents something special that is worth preserving and protecting. Therefore, this Court should make clear: (1) what standard a Defendant must meet to raise this defense, (2) what burden Plaintiff must meet once this defense is raised, (3) what standard the Courts should use in evaluating this defense, and (4) how this issue should be resolved when the record contains evidence that reasonable minds can differ about defendants' good-faith beliefs.

Statutory Interpretation: In 1999, as part of the Omnibus Appropriations Act, Congress passed the ACPA. The ACPA was inserted into the Appropriations Act at approximately 3:06

in the morning the day it was up for a final vote in the House. Parts of the ACPA are calculated to have (and have had since passage) an extraordinary *in terrorem* chilling effect on speech and on Internet commerce – by (1) establishing a vague and unpredictable test for liability involving a "non-exclusive" list of "factors," and (2) permitting plaintiffs to wield the punitive threat of up to $100,000 in statutory damages, in the event that a violation is found. However, wiser heads were not completely excluded from the process. Senator Leahy, among others, insisted upon protections for speech – including traditional principles of "fair use" – that became an integral part of the final legislative product. The ACPA therefore includes an explicit "good faith" defense that Defendants are permitted to invoke. The defense has two elements: (1) a subjective belief that the "use" of an Internet Domain Name is "a fair use or otherwise lawful," and (2) the defendant has "reasonable grounds" for this subjective belief at the time of the "use."

In this case, Defendants have raised the question of what specific steps are required – as a matter of law – in order to mount an "objective reasonableness" defense under the ACPA, as well as the question of what legal analysis applies when such a defense is raised. The First Circuit blatantly dodged this question by mischaracterizing the arguments in Defendants-Appellants' Brief as a factual, rather than a legal inquiry about the trial court's interpretation of 15 U.S.C. § 1125(d)(1)(B)(ii).

It is simply inappropriate to circumvent this defense – as the courts below have done – by denying the very existence of defendants' subjective beliefs instead of considering the objective reasonableness of their actual, subjective beliefs. In this case, the "changing story" vehicle the trial court has sought to employ (much like the story of the blind elders encountering an elephant) depends on the faulty notion that, simply because different aspects of the same defense (none of which are contradictory, all of which are true, and none of which have ever been retracted or "changed") have been emphasized at

different times, nevertheless the "elephant" (the subjective "fair use or otherwise lawful" belief of defendants) does not exist because "an animal cannot be a tree, a snake, a spear, and a wall – all at the same time."

Given the exploding volume of ACPA cases in the lower courts, and the remarkable scarcity of ACPA defendants with the financial resources to shepherd this statutory interpretation question to the Certiorari petition stage,[28] Petitioners respectfully submit that the Court should address this statutory issue in this case. Addressing this issue now will help ensure that the ACPA "objective reasonableness" defense (dismissively termed the "escape clause" by the courts below) remains a robust vehicle for protecting important expressive rights and maintaining a zone Internet freedom, in which creativity and inventiveness are permitted to flourish.

Transient Jurisdiction and *Burnham*: Service-in-the-courtroom certainly was not the original focus of the appeal[29]

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[28]Petitioners, upon request, will be happy to supply the Court with numerous examples of misconduct and abuse by trademark owners. E.g., *K2r Produkte AG v. Jeremie Trigano*, Case No. D2000-0622 (WIPO Aug. 23, 2000), < http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0622.html >(Debevoise & Plimpton Law firm found guilty of "reverse hijacking."); compare Brad Templeton, rec.humor.funny v. MasterCard (Apr. 9, 2001), < http://www.netfunny.com/rhf/jokes/01/Apr/mcrhf.html >, and <http://netfunny.com/rhf/price.html >; with < http://www.rotten.com/legal/desist-mastercard.html >. Almost all Domain Name registrants – even if engaged in clearly non-infringing conduct – tend not to have counsel and often capitulate in the face of threatening "cease-and-desist" letters. A helpful exercise is to use Google or another search engine to review the results of searches for (1) "cease desist letter," "bigfoot letter," and "cease desist trademark." Although each search will pull up well over 10,000 documents, a fair number within the first hundred or so from each search should be instructive.

[29]The issue was not raised in Appellants' Opening Brief, but only in the Appellee's Brief. Defendants, in reply, merely pointed out that the trial (continued...)

but inexplicably it became the focus of the appeals court's opinion. As a result, this case presents an important opportunity to resolve the sharp differences expressed in *Burnham*,[30] and to explain whether:

(1) the Defendant who was served in this case – Mr. Burgar – is immune from "transient jurisdiction" because traditional principles of immunity – as well as deference to Massachusetts law – preclude its application; or

(2) Mr. Burgar is not subject to jurisdiction because – whatever the facts might have been in *Burnham* – this case is different and jurisdiction predicated on in-courtroom "second service" clearly does not pass the "fair play and substantial justice" test.

The *Burnham* case itself did not specifically address the fact pattern involved in this case. Dennis Burnham, a resident of New Jersey, traveled to California – where his estranged wife and the couple's two daughters resided – in January 1988. *Burnham*, 495 U.S. at 607-08. Burnham originally visited the

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[29](...continued)
court expressly chose not to address this issue, identified a number of cases (including many cases turning on process immunity) that supported the view that "second service" in the courtroom should not trigger personal jurisdiction, and pointed out (correctly) that the best course was to remand this issue for further development and briefing. Instead, the First Circuit permitted Appellee to change the subject entirely.

[30]Also relevant to this discussion, and the continuing viability of *Burnham*, are the negotiations presently underway concerning the draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters. See Hague Conference on Private International Law, Preliminary Draft Convention on Jurisdiction In Civil And Commercial Matters (Oct. 30, 1999), *published at* < http://www.hcch.net/e/conventions/draft36e.html >. All of the major trading partners of the United States strongly object to the *Burnham* transient jurisdiction rule. The Hague Jurisdiction and Judgments Convention is likely to harmonize U.S. law on this point with the governing law in the overwhelming majority of industrial democracies.

Los Angeles area on business, and then traveled north to San Francisco, to visit his children. Id. at 608. After spending the weekend, and upon returning his older daughter home, Mr. Burnham was served with summons for a divorce suit his wife had filed in California state court. Id. The California courts rejected Mr. Burnham's efforts to have the case dismissed for lack of personal jurisdiction. This Court affirmed.

However, the Court was sharply split on the reasons for affirming California's exercise of personal jurisdiction over the vacationing Mr. Burnham. Justice White joined parts I, II-A, II-B, and II-C of Justice Scalia's opinion – but significantly not parts II-D or III. Justice White rejected the view that "as a general proposition . . . the [transient] rule is so arbitrary . . . in so many instances that it should be held violative of due process in every case." Id. at 628. Nor did he view Mr. Burnham's circumstances as affording a viable basis for an as-applied challenge. While Justice White did not rule out the possibility that some other "transient jurisdiction" case could violate due process on an as applied basis, "until such a showing is made, which would be difficult indeed," Justice White saw no need to opine further in *Burnham*. Id.

Justice Scalia, the Chief Justice and Justice Kennedy, however, took the additional step of opining that *Shaffer v. Heitner* does not require an individualized due process determination in each case of "transient jurisdiction" resulting from service upon someone present in the forum. Justice Scalia found support in the historical pedigree of the "transient jurisdiction" rule. Id. at 619-28. Justice Brennan, joined by Justices O'Connor, Blackmun, and Marshall, strongly disagreed with Justice Scalia. Although these four Justices – like Justice White – agreed that the exercise of "transient jurisdiction" on the facts of the *Burnham* case would not violate due process, Justice Brennan's opinion also took Justice Scalia's opinion to task for its methodology. "[R]eliance solely on historical pedigree," according to Justice Brennan, "is foreclosed" by

International Shoe and *Shaffer v. Heitner*, 433 U.S. 177 (1977). *Burnham*, at 629. Justice Stevens, "concerned about [the] unnecessarily broad reach" of the opinions of Justices Scalia and Brennan, "agree[d] that the judgment should be affirmed" in "a very easy case." Id. at 640.

A clear majority of the Court (6 justices in all) in *Burnham* left open the possibility that there might be specific categories of factual circumstances, in which application of the general theory of "transient jurisdiction" runs afoul of due process,[31] because in those specific classes of cases (i.e., service in the courtroom, or when traveling to or from court, upon a party who has entered the forum for no other reason than to press a defense of lack of personal jurisdiction), mechanical application of transient jurisdiction does not meet the standard of "fair play and substantial justice." Burnham, 495 U.S. at 637 n.11, 639 ("The facts of the instant case do not require us to determine the outer limits of the transient jurisdiction rule."); see also Id. at 631-32, nn.4-5 (1990) (Brennan, J., concurring) (citing cases and academic literature).

In this case, the defendant who was served had never previously been to Massachusetts. He had been made a party unwillingly to litigation in Massachusetts. Although the courtroom deputy had been contacted in advance and did not know whether the judge would elect to take testimony or not, it was made clear enough that this Defendant was also a witness who would make himself available under oath if the court required clarification of any facts (and, in fact, it turned out the

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[31]Justice Scalia also does not appear to favor abrogation of traditional exceptions to "transient jurisdiction" – force, fraud, or process immunity, for example – must be abrogated. *Burnham*, 495 U.S. at 613-15. It is not clear from *Burnham* whether he believes the due process clauses reinforce these exceptions (e.g., by prohibiting Congress from passing a statute that authorizes courts to take jurisdiction over foreign persons who are forcibly abducted and transported to the forum).

court did need clarification – even if, on account of a scheduling conflict, the court lacked time to take testimony).

The idea that he could be deprived of **the very defense** that he sought to assert that day – through the artifice of "second service" while the judge was on the bench, simply cannot comport with "fair play and substantial justice."

Numerous courts addressing this exact issue have recognized that "second service" upon a party present to assert the defense of lack of personal jurisdiction, does not enable a court to take jurisdiction over a Defendant. *Bailey v. Transportation-Communication Employees Union*, 45 F.R.D. 444, 447-48 (N.D. Miss. 1968); *Kelly v. Pennington*, 78 Colo. 482, 484, 242 P. 681, 682, 45 A.L.R. 339 (1926); and *Singer v. Reising*, 154 Misc. 239, 240-41, 276 N.Y.S. 714, 715-17 (N.Y. Mun. Ct. 1935). See also *Chase Nat'l Bank v. Turner*, 269 N.Y. 397, 199 N.E. 636, 637 (1936).

The minority – and facially incorrect – view is represented by *LaCroix v. American Horse Show Ass'n*, 853 F. Supp. 992 (N.D. Oh. 1994) (jurisdiction over party and its lawyers premised on service upon lawyers at jurisdiction hearing), on which the appeals court relied.

Further, the overwhelming majority of courts interpreting *Lamb v. Schmitt* conclude that its holding is much narrower than the First Circuit suggests – quite a reasonable view inasmuch as the *Lamb* case arose out of a fact pattern involving fraudulent transfers to a lawyer, in order to avoid a judgment – which clearly differs from the facts of the present case.[32]

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[32]See also Kelly, at 484-85 (" . . . yet the same cases, in stating the general rule, do not limit its application to another or new action, but say that the exemption is from service of civil process in any action."); Shapiro & Son, 348 F.2d at 461 ("Certainly, the mere presence of the relationship is insufficient to dispel the immunity."); Frier v. Terry, 230 Ark. 302, 304 323 S.W.2d 415, 417 (1959); In re Equitable Plan Co., 277 F.2d 319, 321 (2d Cir. 1960) (citing Page Co. v. MacDonald,, 261 U.S. 446 (1923)); Peet v. (continued...)

American Centennial Ins. Co. v. Handal, 901 F. Supp. 892, 895-97 (D.N.J. 1995); *International Plastic Harmonica Corp. v. Harmonic Reed Corp.*, 69 F. Supp. 515, 516 (E.D. Pa. 1946); *Shapiro & Son Curtain Corp. v. Glass*, 348 F.2d 460, 461-62 (2d Cir. 1965); *Fun-Damental, Too v. Hwung*, 1997 WL 289712, at *3-*5 (S.D.N.Y. May 30, 1997); *Viking Penguin, Inc. v. Janklow*, 98 F.R.D. 763, 765-67 (S.D.N.Y 1983); *NASL Marketing, Inc. v. de Vries*, 94 F.R.D. 309, 309-11 (S.D.N.Y. 1982). Contrary to Plaintiff's views on the matter-- Mr. Burgar had every reason to believe that his attendance at the January 19, 2000 hearing rendered him immune from Plaintiff's in-courtroom "second service" stunt.

Moreover, there is no reason to believe that *Lamb*, 285 U.S. 222 (1932), the Mississippi case relied upon so heavily by the circuit court, in any way requires the dramatic and sweeping change in Massachusetts law that the First Circuit suggests. Quite the contrary, Massachusetts law and court precedents should supply the governing rule. 28 U.S.C. § 1652; see also *Wilson v. Garcia*, 471 U.S. 261 (1985); *Walker v. Armco Steel Corp.*, 446 U.S 740 (1980) (diversity case). Under Massachusetts law[33] – including both longstanding state law and federal rulings interpreting and applying Massachusetts

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[32](...continued)
Fowler, 170 F. 618, 619 (C.C. Pa. 1909); In re Healey, 53 Vt. 694, 1881 WL 7823 (1881).

[33]Massachusetts law holds that the formality of seeking or obtaining a court order, authorizing travel into the forum, is not required. *Valley Bank & Trust Co. v. Marrewa*, 354 Mass. 403, 404-05, 237 N.E.2d 677, 678-79 (1968); *Diamond v. Earle*, 217 Mass. 499, 500, 105 N.E. 363, 363 (1914); *In re Thompson*, 122 Mass. 428, 428, 1877 WL 10168, at *1, 23 Am. Rep. 370 (1877); *May v. Shumway*, 16 Gray 86, 82 Mass. 86, 1860 WL 8502 (1860).

law[34] – Mr. Burgar also had every reason to believe on January 19, 2000 that immunity from process was not conditioned upon first moving for a protective order. In Massachusetts,

> [Process immunity] is **not merely a privilege of the person**; it is a prerogative exerted by the sovereign power through the courts for the furtherance of the ends of justice. **Every party has a right to testify in his own behalf.** The rule . . . is extended generally to defendants living outside the state . . . .

Diamond, 105 Mass. at 501 (emphasis added). No Massachusetts court ever has recognized any of the exceptions that the First Circuit sought to establish and apply retroactively in this case.

The proposed "protective order" rule is directly contrary to prior controlling Massachusetts law:

> It has long been settled that parties and witnesses attending in good faith any legal tribunal, **with or without a writ of protection**, are privileged from arrest on civil process during their attendance, and for a reasonable time in going and returning.

Larned v. Griffin, 12 F. 590, 590 (C.C. Mass. 1882) (emphasis added); *Valley Bank & Trust Co. v. Marrewa*, 354 Mass. 403, 404-05, 237 N.E.2d 677, 678-79 (1968); *Diamond v. Earle*, 217 Mass. 499, 500, 105 N.E. 363, 363 (1914); *In re Thompson*, 122 Mass. 428, 428 1877 WL 10168, at *1, 23 Am. Rep. 370 (1877); see also *Stewart v. Ramsay*, 242 U.S. 128, 129 (1916).

Due Process and "Internet Contacts:" The advent of the global Internet requires this Court to re-visit many important issues of personal jurisdiction – several of which are squarely presented in this case. Lower courts have had great difficulty adapting traditional principles of law to resolve evolving Internet-related issues. *See, e.g., Bensusan Restaurant Corp. v.*

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[34] *Larned v. Griffin*, 12 F. 590, 590 (C.C. Mass. 1882) (emphasis added).

King, 126 F.3d 25, 27 (2nd Cir. 1997) (in trademark case, comparing the attempt "to apply established . . .law in the fast-developing world of the [I]nternet" to the difficulty of "trying to board a moving bus").

Particularly on questions of personal jurisdiction, trial and appellate courts have been all over the map.[35] Indeed, the

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[35]Compare, e.g., *Hornell Brewing Co. v. Rosebud Sioux Tribal Court*, 133 F.3d 1087 (8th Cir. 1998) (no jurisdiction based on Internet "contacts"); *Heathmount A.E. Corp v. Technodome.Com*, 106 F. Supp. 860 (E.D. Va. 2000) (no personal jurisdiction), *certified for interlocutory appeal*, No. 01-1153 (4th Cir. Feb. 2, 2001); *America Online, Inc. v. Huang*, 106 F. Supp. 2d 848 (E.D. Va. 2000) (no jurisdiction based on Internet "contacts"); *Winfield Collection, Ltd. v. McCauley*, 105 F. Supp. 2d 746 (E.D. Mich. 2000) (same); *Berthold Types Ltd. v. European Mikrograf Corp.*, 102 F. Supp. 2d 928 (N.D. Ill. 2000) (same); *Search Force, Inc. v. DataForce Intern., Inc.*, 112 F. Supp. 2d 771 (S.D. Ind. 2000) (same); *Dagesse v. Plant Hotel N.V.*, 113 F. Supp. 2d 211, 220 (D.N.H. 2000) (same); *Bailey v. Turbine Design, Inc.*, 86 F. Supp. 2d 790 (W.D. Tenn. 2000) (same); *Perry v. RightOn.com*, 90 F. Supp. 2d 1138 (D. Or. 2000); *Neogen Corp. v. Neo Gen Screening, Inc.*, 109 F. Supp. 2d 724 (W.D. Mich. Aug 21, 2000) (same); *Millennium Enters., Inc. v. Millennium Music, LP*, 33 F. Supp. 2d 907, 910-24 (D. Or. 1999) (same); *Rothschild Berry Farm v. Serendipity Group LLC*, 84 F. Supp. 2d 904, 909 (S.D. Ohio 1999) (same); *Molnlycke Health Care, AB v. Dumex Medical Surgical Prods., Ltd.*, 64 F. Supp. 2d 448 (E.D. Pa. 1999) (same); *Rannoch, Inc. v. Rannoch Corp.*, 52 F. Supp. 2d 681 (E.D. Va. 1999) (same); *Barrett v. Catacombs Press*, 44 F. Supp. 2d 717 (E.D. Pa. 1999) (same); *ESAB Group, Inc. v. Centricut, LLC*, 34 F. Supp. 2d 323 (D.S.C. 1999) (same); *Mallinckrodt Medical, Inc. v. Sonus Pharmaceuticals, Inc.*, 989 F. Supp. 265 (D.D.C. 1998) (same); *Fernandez v. McDaniel Controls, Inc.*, 999 F. Supp. 1365 (D. Haw. 1998) (same); *Edberg v. Neogen Corp.*, 17 F. Supp. 2d 104 (D. Conn. 1998) (same); *E-Data Corp. v. Micropatent Corp.*, 989 F. Supp. 173 (D. Conn. 1997) (same); with *Ford Motor Co. v. Great Domains, Inc.*, No. 00-CV-71544-DT, __ F. Supp. 2d __, 2001 WL 348986 (E.D. Mich. Mar 30, 2001) (inventing fanciful "lexical context" theory of jurisdiction); *Cello Holdings, LLC. v. Lawrence-Dahl Cos.*, 89 F. Supp. 2d 464 (S.D.N.Y.2000); *Euromarket Designs, Inc. v. Crate & Barrel Ltd.*, 96 F.Supp.2d 824, 836 (N.D.Ill.2000); *Coastal Video Comm'ns Corp. v. Staywell Corp.*, 59 F. Supp. 2d 562 (E.D.Va. 1999); *Sports Authority* (continued...)

circuits already are split on the issue of the proper legal standard or method of analysis to apply when a plaintiff attempts to assert personal jurisdiction on an "Internet contacts," or "interactive Website" theory. Compare *GTE New Media Servs.*, 199 F.3d 1343, 1349-50 (D.C. Cir. 2000), and *Bensusan Restaurant Corp. v. King*, 126 F.3d 25 (2nd Cir. 1997), with *Mink v. AAAA Development LLC*, 190 F.3d 333 (5th Cir. 1999), and *Soma Medical Intern. v. Standard Chtd. Bank*, 196 F.3d 1292 (10th Cir.1999), and *Zippo Mfg. Co. v. Zippo Dot Com, Inc.*, 952 F. Supp. 1119 (W.D. Pa. 1997). See also *Recent Case: Civil Procedure – D.C. Circuit Rejects Sliding Scale Approach to Finding Personal Jurisdiction Based on Internet Contacts – GTE New Media Services Inc. v. Bellsouth Corp.*, 113 HARV. L.R. 1128 (2000). The lower courts need guidance in this area, and certiorari should be granted in this case in order to provide that guidance.

Scope of the Injunction: On March 31, 2001, the trial court entered an order enjoining (or declining to stop enjoining) the Canadian publisher of a Website unwillingly to publish content of the trial court's choosing – drafted with assistance of Plaintiff NLT. The trial court's March 31 Order contains no rationale for exercising such excessive, sweeping, and unnecessary content control over the Website. Nor does the trial court's opinion identify any justification whatsoever for depriving Defendants of important, non-infringing expressive opportunities, for rejecting alternatives, or for deliberately

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[35](...continued)
Michigan, Inc. v. Justballs, Inc., 97 F. Supp. 2d 906 (E.D. Mich. 2000); *Bochan v. LaFontaine*, 68 F. Supp. 2d 692 (E.D. Va. 1999); *PurCo Fleet Services, Inc. v. Towers*, 38 F. Supp.2 d 1320 (D. Utah 1999); *Zippo Mfg. Co. v. Zippo Dot Com, Inc.*, 952 F. Supp. 1119 (W.D.Pa. 1997) (genesis of "sliding scale" approach); *Inset Systems, Inc. v. Instruction Set, Inc.*, 937 F. Supp. 161 (D. Conn. 1996) (Taking jurisdiction based on "24 hours a day, 7 days a week," Website visibility theory); *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1328 (E.D. Mo.1996).

suppressing Defendants' speech and press rights.

The mechanism of suppression selected by the trial court has been to hide Defendants' expression behind a blacked-out "greeting page" that deliberately diverts a substantial portion of Defendants' audience away from the Website before these visitors have a chance to see Defendants' published message.

The injunction is directly analogous to an order permitting Planned Parenthood to distribute leaflets only if those leaflets are enclosed in black envelopes bearing the telephone number of Operation Rescue, or permitting Planned Parenthood to distribute leaflets only if they first erect a gigantic black wall between themselves and their audience, thereafter communicating only with audience members who bother to walk through a door in the wall. The trial court's injunction is hardly the least restrictive means to accomplish the trial court's identified objectives.

Because the injunction dictates the entire substantive content of the Website "homepage," and does so without necessity or a compelling justification, it violatea the prohibition against "forced speech" set forth in such cases as *Wooley v. Maynard*, 430 U.S. 705, 714 (1977), and *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995). The injunciton also fails "strict scrutiny, which applies to all content-based regulations. E.g., *Perry Education Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45 (1983), *Simon & Schuster, Inc. v. Crime Victims Bd. of New York*, 502 U.S. 105, 115-18 (1992). Third, it violates *Madsen v. Women's Health Ctr., Inc.*, 512 U.S. 753 (1994), which requires that all injunctions (even content-neutral ones that only incidentally burden speech) must "burden no more speech than necessary to serve a significant government interest?" Finally, it violates fundamental principles governing allinjunctions.

The Court of appeals clearly shirked its duty under 28 U.S.C. § 1292(a)(1), by dodging these important questions and leaving this speech-suppressing injunction in place.

CONCLUSION

Accordingly, for the reasons set forth above, Petitioners pray that the petition for certiorari be granted, that the judgment of the circuit court be reversed, and that the case be remanded with instructions to dissolve the injunction and to dismiss all claims against defendants for lack of personal jurisdiction.

Respectfully Submitted,

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Jeffrey K. Burgar, and
641271 Alberta, Ltd., d/b/a
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(2) Supreme Court, U.S.
FILED
001651 APR 30 2001
OFFICE OF THE CLERK

No.

IN THE

Supreme Court of the United States

NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

APPENDIX TO THE PETITION FOR WRIT OF CERTIORARI (VOLUME I) -

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[Appendix F shall be submitted separately,
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shall be included as an Appendix only with leave].

Appendix A.

United States Court of Appeals
For the First Circuit

No. 00-1641

NORTHERN LIGHT TECHNOLOGY, INC.,
Plaintiff, Appellee,
v.
NORTHERN LIGHTS CLUB, JEFFREY K. BURGAR, AND
641271 ALBERTA LTD., D/B/A NORTHERN LIGHTS CLUB,
Defendants, Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
[Hon. Douglas P. Woodlock, U.S. District Judge]

Before
Selya, Boudin and Stahl,
Circuit Judges.

Eric C. Grimm, with whom CyberBrief, PLC, Theodore A. Lund, and Gaeta, Courville & Lund, were on brief for appellant.

Bernard J. Bonn, III, with whom Barry S. Pollack, and Dechert Price & Rhoads, were on brief for appellee.

January 8, 2001

STAHL, Circuit Judge. This case involves a dispute over the simultaneous use of two similar Internet domain names by two separate entities. Defendants-appellants Northern Lights Club, Jeff Burgar and 641271 Alberta Ltd. (collectively "Northern Lights" or "defendants") appeal a preliminary injunction entered by the district court requiring the posting of a specified disclaimer on their World Wide Web site's portal page. The court entered the injunction after finding that plaintiff-appellee Northern Light Technology, Inc. ("Northern Light" or "plaintiff") was likely to prevail on the merits of its state and federal trademark claims and its claim under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) ("ACPA").

Defendants assert three bases for relief in this interlocutory appeal: (1) that the district court lacks personal jurisdiction, and hence the power to enjoin them; (2) that the district court erred in concluding that the plaintiff was likely to succeed on the merits of its claims; and (3) that the injunction currently in place is overly broad and consequently infringes their free-speech rights. Finding that the district court properly acquired jurisdiction over defendants when their agent was served with process within the forum state, and discerning no basis for disturbing the district court's determination on the likely success of plaintiff's suit, we uphold the district court's issuance of a preliminary injunction. And because defendants only obliquely pressed their First Amendment argument before the district court, we decline to decide the issue for purposes of this appeal.

a. Background

The facts of this case are extensively chronicled in the district court's opinion, see Northern Light Tech., Inc. v. Northern Lights Club, 97 F. Supp. 2d 96 (D. Mass. 2000), and so we confine our discussion to the events relevant to this appeal. On September 16, 1996, plaintiff registered the Internet domain name northernlight.com with Network Solutions, Inc. ("NSI"), which at that time was the organization exclusively

entrusted with the task of registering domain names on the World Wide Web.[1] Plaintiff also filed registration papers for the "Northern Light" service mark with the United States Patent and Trademark Office ("PTO") during that same month.[2] Nearly a year later, in August 1997, plaintiff began its operation of the northernlight.com website (and, consequently, its use of the "Northern Light" mark in commerce) as a search engine. Search engines are popular Web-retrieval tools that match a search query submitted by an Internet user with the websites whose content best corresponds to the submitted search terms. The northernlight.com site has remained in continuous existence as a search engine since August 1997.

Defendant Jeff Burgar, a resident of High Prairie, Alberta, Canada, is the president and principal shareholder of 641271 Alberta, Ltd., an Alberta corporation that owns the northernlights.com domain name. Burgar, a self-described "Internet entrepreneur," has, since the mid-1990s, registered thousands of "catchy" domain names – i.e., Internet addresses appropriating, in identical or slightly modified form, the names of popular people and organizations. He is also the president of Northern Lights Club, an unincorporated association with a listed address in Las Vegas, Nevada. While Northern Lights Club's stated mission is to bring together devotees of the Northern Lights, or aurora borealis, including businesses that take their name from the famous celestial phenomenon,

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[1]As they are commonly used today, Internet domain names serve two principal functions: (1) providing the addresses for hypertext markup language ("HTML") sites on the World Wide Web, and (2) permitting the dissemination of e-mail accounts with a common suffix that reflects the identity of the accounts' proprietor.

[2]The PTO issued plaintiff a registered trademark for "Northern Light" on February 23, 1999.

Burgar's testimony indicates that the club has no actual individual members.

In October 1996, approximately one month after plaintiff registered its northernlight.com website, Burgar, on behalf of Northern Lights Club, registered the northernlights.com domain name with NSI.[3] Soon after registration, Burgar licensed the name to FlairMail, a vanity e-mail service that he manages and that is owned by a local Alberta newspaper.[4] Burgar "believes" that this newspaper is owned by his wife. Under this arrangement with FlairMail, defendants offered e-mail accounts under the northernlights.com domain name that users could access through some other website, such as flairmail.com, although Internet users who attempted to visit the northernlights.com page on the World Wide Web would find that no such site existed.[5]

The two similar domain-name registrations enjoyed a peaceful coexistence until March 2, 1999, when a USA Today story on Internet search engines erroneously identified plaintiff's website as northernlights.com. After ascertaining that defendants were the owners of this domain name, plaintiff's marketing director contacted Burgar to find out whether defendants might be interested in selling it. The parties exchanged a series of proposals and counterproposals by e-mail

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[3]Plaintiff does not allege that defendants had actual knowledge of the northernlight.com registration when they registered the northernlights.com domain name.

[4]Vanity e-mail permits a subscriber to choose both the user name and the domain name for their e-mail address. To use as an example the service offered by defendants, an admirer of the aurora borealis named John Doe could choose the vanity e-mail address "John.Doe@northernlights.com."

[5]The district court found, at the time of its March 2000 opinion, that approximately 112 individuals used the northernlights.com domain name as part of their vanity e-mail address. See 97 F. Supp. 2d at 101.

over a two-month period but ultimately no sales or licensing agreement was consummated. Soon thereafter, in April 1999, defendants posted an active page on the northernlights.com World Wide Web site. Visitors to the site saw, among other things, a site-search function near the top of the screen that enabled users to perform a search of the northernlights.com site for specific words or phrases, as well as links to FlairMail and other members of the "Northern Lights Community." Plaintiff's Web site was placed third in the list of the Northern Lights Community "Business Listings."[6] Plaintiff had not agreed to this listing.

On July 14, 1999, plaintiff sent Burgar a cease-and-desist letter, demanding that the northernlights.com site be deactivated. Defendants chose not to respond to this letter. Fifteen days later, plaintiff asked NSI to strip defendants of the northernlights.com domain name based on the similarity of their respective marks, but NSI declined, citing the one-letter discrepancy between the name of defendant's website and plaintiff's trademark. On August 6, 1999, plaintiff filed the instant lawsuit under federal and state theories of unfair competition, trademark infringement, and trademark dilution. In its complaint, plaintiff sought both a temporary restraining order and a preliminary injunction. In December 1999, plaintiff amended its complaint to add a claim under ACPA (which had been enacted into law less than one month earlier) and to abandon its federal trademark-dilution claim and its state-law claims of unfair competition and trademark dilution.

Moments before the district court hearing on September 1, 1999 to consider the merits of plaintiff's claims and the court's personal jurisdiction over defendants, plaintiff's agent

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[6]Plaintiff asserts that it received approximately 300 referrals per day from defendants' site about the time that the northernlights.com site went online, and that this number later increased to several thousand referrals per day.

physically served process upon Burgar, who had traveled voluntarily to Boston from Alberta to witness the proceedings and to make himself available for testimony if needed. Although the hearing itself focused largely on the convoluted issues of personal jurisdiction arising from Internet activities, it also touched upon the merits of plaintiff's request for preliminary injunctive relief. At the end of the hearing, the district court indicated that it would issue a temporary restraining order modifying the content of the northernlights.com site to prevent further public confusion, and solicited advice from both parties as to the appropriate substance of that order.

True to its word, the district court imposed the TRO the following day, stating that Northern Light had successfully demonstrated probable personal jurisdiction, that it would be likely to succeed in its trademark-infringement suit, and that the balance of hardships and the public interest favored temporary relief. The court ordered that defendants remove all content from the northernlights.com site and post in its place a blacked-out screen containing only an image of the aurora borealis and links to three websites: (1) flairmail.com (where users could access their northernlights.com e-mail accounts); (2) plaintiff's northernlight.com site; and (3) the content page that formerly existed at northernlights.com, to be described, for purposes of the link, as "BUSINESSES THAT ARE LISTED WITH THE NORTHERN LIGHTS COMMUNITY." On the same day that this ruling was issued, the parties jointly moved the court for a continuance of "at least 60 days." In this joint motion, defendants acquiesced in an extension of the restraining order against them until discovery and further hearings in the matter were conducted, and the parties agreed to a schedule governing the completion of discovery and the filing of any additional motions. The court granted this motion, and both parties submitted further motions during this period. After granting several motions for extensions of time, the district court

ultimately held hearings on January 19 and 21, 2000 on the personal-jurisdiction issue and the merits of plaintiff's request for preliminary relief.

In its written opinion issued on March 31, 2000, the district court ordered, inter alia, that what had become a de facto preliminary injunction should remain in place.[7] In so doing, the court began by holding that it had personal jurisdiction over defendants.[8] It determined that plaintiff had satisfied sections 3(c) and 3(d) of the Massachusetts Long-Arm Statute, see Mass. Gen. Laws ch. 223A, § 3, because defendants had likely caused tortious injury to plaintiffs in Massachusetts, both through their acts within the Commonwealth (in the form of their trademark-infringing website) and their regular solicitation of business through acts outside of the Commonwealth (by virtue of, inter alia, the site's "entice[ment]" to users to post material). See 97 F.Supp.2d at 104-06. The court also found that defendants had sufficient contacts with Massachusetts to support the exercise of specific jurisdiction under International Shoe Co. v. Washington, 326 U.S. 310 (1945), thereby satisfying the

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[7]The record does not clearly reveal when the TRO became a preliminary injunction. At some point following the submission of their joint motion for continuance, the parties (and the district court) started describing the TRO as a preliminary injunction. Furthermore, in its written opinion, the district court stated that the preliminary injunction already in place would not be modified. In any event, the present appeal clearly is from a preliminary injunction.

[8]The district court noted that its decision was responsive to a plethora of pretrial motions pending before it, including motions to dismiss for lack of personal jurisdiction and for failure to state a claim; plaintiff's initial motion for a preliminary injunction; defendants' motions for reconsideration of the temporary relief that had already been ordered; and the parties' motions to compel discovery and to impose sanctions. See 97 F. Supp. 2d at 98.

constitutional due-process element of personal jurisdiction. See Northern Light, 97 F.Supp.2d at 106-08.

On the merits of plaintiff's suit, the district court found that, based on the likelihood of confusion between the two websites because of their similar form and function, plaintiff's state and federal trademark-infringement and unfair-competition causes of action would probably succeed. See id. at 109-15, 120. The court further opined that plaintiff was likely to succeed on its ACPA claim, based on the confusing similarity of the two domain names and proof of defendants' bad-faith intent to profit from plaintiff's northernlight.com mark. See id. at 115-20. On the latter issue, the court reasoned that, although Burgar's initial reluctance to sell the northernlights.com site and defendants' uninterrupted use of the northernlights.com name for vanity e-mail accounts militated against a bad-faith finding, defendants' historical practice of "targeting trademarked names, creating fictional entities to register them, and offering dubious explanations for the selection of these domain names" ultimately tipped the scales in favor of such a preliminary determination. Id. at 119. Finally, the district court found that plaintiff had established a likelihood of irreparable harm, that the balance of hardships favored the plaintiff, and that the public interest favored the preservation of the preliminary injunction already in place. See id. at 120-21.

On appeal, defendants dispute the district court's personal-jurisdiction ruling and aspects of its decision regarding the likelihood of plaintiff's success on the merits. Defendants also pursue their argument, not expressly considered by the district court, that the present injunction unduly burdens their First Amendment rights.

II. Personal Jurisdiction

Defendants first challenge the injunction entered by the district court on the ground that the court was without personal jurisdiction to order such a remedy. At each stage of the proceedings, the parties have contested whether defendants'

activities, both in terms of the content of their website and their discussions with the plaintiff regarding a potential business venture, meet the personal-jurisdiction criteria of the Massachusetts Long-Arm Statute and the requirements of due process. Plaintiff also posited a more conventional basis for personal jurisdiction in the district court – namely, the service of process effected upon Burgar just prior to the September 1, 1999 preliminary injunction hearing. We afford plenary review to the district court's determination of personal jurisdiction, and may affirm its judgment for any independent reason supported by the record. See, e.g., Phillips Exeter Acad. v. Howard Phillips Fund, Inc., 196 F.3d 284, 288 (1st Cir. 1999).

The district court expressly declined to consider the validity of personal jurisdiction based on physical service of process. See 97 F. Supp. 2d at 108 n.12. On appeal, however, plaintiff continues to press its case that, under the doctrine of transient jurisdiction, it has satisfactorily created jurisdiction through its service of process on Burgar prior to the September 1, 1999 hearing. See Burnham v. Superior Court of Cal., 495 U.S. 604 (1990) (plurality opinion); Schinkel v. Maxi-Holding, Inc., 565 N.E.2d 1219, 1222-23 (Mass. App. Ct. 1991) (holding that personal jurisdiction in Massachusetts need not be predicated on Long-Arm Statute when defendant served with process while in forum under transient-jurisdiction doctrine). Defendants dispute this proposition, claiming that this method of service of process is fundamentally unfair in that it represents a trap for the unwary litigant who travels to the forum state solely to contest the issue of personal jurisdiction. Defendants also argue that permitting service of process under these circumstances is unwise from a public-policy perspective in that it discourages the litigant from actively assisting the district court in the jurisdictional- discovery process.

Although they do not specifically ask for process immunity, defendants' argument against personal jurisdiction essentially boils down to a request that Burgar be deemed immune from

service of process since, at the time he was served, he was present in Massachusetts only for the purpose of attending a personal-jurisdiction hearing in this lawsuit. This argument enjoys some measure of historical pedigree, albeit in a related context. Long before the Supreme Court in Burnham affirmed that personal jurisdiction can be sustained against a defendant solely on the basis of his presence in the forum state at the time of service of process, it had recognized that some parties temporarily in the forum state enjoy immunity from service by virtue of their status as participants in ongoing litigation. For instance, in Lamb v. Schmitt, 285 U.S. 222 (1932), the Court noted the potential peril of allowing an individual who is attending a proceeding in one suit to be served with process in conjunction with another:

> [T]he due administration of justice requires that a court shall not permit interference with the progress of a cause pending before it, by the service of process in other suits, which would prevent, or the fear of which might tend to discourage, the voluntary attendance of those whose presence is necessary or convenient to the judicial administration in the pending litigation.

Id. at 225 (internal citations omitted). Similarly, Justice Scalia's plurality opinion in Burnham referred to several states' historical imposition of statutory or common-law prohibitions on the service of process of those individuals present in the forum as parties or witnesses in unrelated judicial proceedings – a practice that led him to conclude that transient jurisdiction comported with constitutional due process. See 495 U.S. at 613.

Accompanying the courts' repeated recognition of the validity of the party/witness immunity exception, however, has been a persistent acknowledgment of the exception's limitations. The Lamb Court itself noted that, because the privilege exists for the convenience of the district court in its exercise of judicial administration, rather than to protect the individual seeking to avoid service of process, courts enjoy the

discretion to confer (or deny) immunity in such instances. See 285 U.S. at 225 (citing Stewart v. Ramsay, 242 U.S. 128, 130 (1916)). Just as importantly, the extension of the privilege has been limited by the majority of courts to cases in which the party or witness was participating in an unrelated litigation at the time that he was served with process in the forum state. See, e.g., ARW Exploration Corp. v. Aguirre, 45 F.3d 1455, 1460 (10th Cir. 1995) (denying process immunity where party was served with process in second lawsuit while attending deposition in first lawsuit alleging similar facts); In re Fish & Neave, 519 F.2d 116, 118 (8th Cir. 1975) (similar); LaCroix v. American Horse Show Ass'n, 853 F. Supp. 992, 994-95 (N.D. Ohio 1994) (applying Lamb and denying defendants' claim of entitlement to immunity based on appearance in forum state solely to contest personal jurisdiction); 4 Charles A. Wright & Arthur R. Miller, Federal Practice and Procedure § 1080, at 511 (2d ed. 1987) ("There is generally no immunity from service of process when the suit in which immunity is sought is part of, or a continuation of, the suit for which the person claiming immunity is in the jurisdiction."); see also Lamb, 285 U.S. at 225 ("[T]he [process-immunity] privilege should not be enlarged beyond the reason upon which it is founded, and . . . should be extended or withheld only as judicial necessities require.").[9] The rationale for the differing-lawsuit prerequisite

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[9]In their brief, defendants cite to other cases, such as American Centennial Ins. Co. v. Handal, 901 F.Supp. 892, 895 (D.N.J.1995), which interpret Lamb differently. Those cases hold that process immunity should be granted to non-residents present in the forum state to participate in any litigation, whether or not related to the suit for which the disputed service has been effected, as long as such immunity does not obstruct justice in the first suit. See, e.g., Shapiro & Son Curtain Corp. v. Glass, 348 F.2d 460, 461-62 (2d Cir.1965); NASL Marketing, Inc. v. de Vries, 94 F.R.D. 309 (S.D.N.Y.1982); United Nations v. Adler, 90 F.Supp. 440, 441 (S.D.N.Y.1950). We reject this view, as Lamb definitively retains the

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to process immunity in this context is relatively straightforward: while a court can, in cases before it, choose to protect the jurisdictional status of a party or witness who is reluctant to come to the forum state by issuing protective orders or subpoenas, it cannot wield such power in other cases. The process-immunity exception therefore fills the gap only where it needs to be filled – that is, in cases where a district court wishes to shield an individual from service of process to encourage his or her travel to the forum state, but would be unable to do so absent the power to grant immunity.

Turning to the facts of this case, several features of defendants' litigation posture counsel against a finding that Burgar is entitled to process immunity. First, and most apparent, is the fact that defendants have never asked the district court for such immunity on behalf of Burgar, either prior to or following the hearing at which Burgar was served with process. In lieu of a specific request for immunity, defendants instead have asked this court to fashion a broad, per se rule precluding the exercise of personal jurisdiction whenever the served individual is in the jurisdiction to attend litigation-related proceedings that pertain to him or her. In light of the admonitions in Lamb and other cases that process immunity should be meted out sparingly, we reject this suggestion. Moreover, the circumstances surrounding the service of process on Burgar are not those that would ordinarily favor a finding of immunity even in a case where it had been timely requested. Specifically, Burgar voluntarily entered into Massachusetts to attend proceedings as a spectator in the same

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[9](...continued)
distinction between presence in the forum state for related and unrelated cases. See 285 U.S. at 225 ("[T]he due administration of justice requires that a court shall not permit interference with the progress of a cause pending before it by the service of process in other suits ....") (emphasis added).

case in which he was served with process. While we need not decide the issue, it seems apparent that under these facts, the district court would have faced a relatively heavy presumption against granting such immunity if it actually had been sought by Burgar.

For these reasons, we hold that the district court properly exercised personal jurisdiction over defendants in this case.[10] Based on this determination, we need not reach the alternate bases for personal jurisdiction discussed in the district court's opinion.

III. Plaintiff's Likelihood of Success on the Merits

Defendants' second claim in this appeal, which goes to the merits of plaintiff's suit, is that the preliminary injunction should be dissolved because it is premised on erroneous findings by the district court. Specifically, defendants claim that the court erred as a matter of fact in determining that Northern Lights manifested a bad-faith intent to profit from plaintiff's mark, and as a matter of law in concluding that ACPA should be applied retroactively to encompass defendants' behavior prior to the enactment of the statute.

A. Defendants' Bad Faith

Defendants vehemently contest the district court's finding that the registration and maintenance of the northernlights.com domain name represented a bad-faith effort to profit from

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[10]We believe that the service of process effected upon Burgar also conferred personal jurisdiction over the other defendants. Burgar serves as the president of both Northern Lights Club, an unincorporated association, and 641271 Alberta, Ltd., a foreign corporation. See Fed. R. Civ. P. 4(h)(1) (permitting personal service of process upon officers of unincorporated associations and foreign corporations).

In all events, defendants have attacked the efficacy of service of process only in general. They have not attacked its efficacy vis-à-vis particular defendants. Consequently, we deem waived any possible argument that personal service upon Burgar was ineffectual as a means of bringing Northern Lights Club and/or 641271 Alberta, Ltd. before the court.

plaintiff's Northern Light trademark. The issue of bad faith is principally relevant to the merits of plaintiff's suit insofar as "bad faith intent to profit from [another's] mark" constitutes an essential element of the cause of action under ACPA. 15 U.S.C. § 1125(d)(1)(A)(i). In this case, however, it also relates, albeit tangentially, to plaintiff's trademark-infringement claim. This is so because the district court's finding with respect to defendants' intent in adopting the Northern Lights mark, which the court rendered while considering one of the eight factors under the "likelihood-of-confusion" test for trademark infringement, see, e.g., I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 43 (1st Cir. 1998), expressly incorporated by reference the intent findings it had made in its ACPA analysis. See 97 F. Supp. 2d at 114. Thus, we must consider the court's "bad-faith intent to profit" findings to the extent that they bear on the trademark-infringement claim. We review the district court's finding of bad faith for clear error. See American Bd. of Psychiatry & Neurology v. Johnson-Powell, 129 F.3d 1, 3 (1st Cir. 1997) (noting clear-error standard of review applies to findings of fact made in conjunction with ruling on motion for preliminary injunction) (citing Keds Corp. v. Renee Int'l Trading Corp., 888 F.2d 215, 222 (1st Cir. 1989)).

On appeal, defendants claim that their conduct did not meet the statutory guidelines for a finding of bad faith, and that even if it did, the subjective and objective reasonableness of their actions should shield them from liability. Defendants stress that their mere registration of multiple domain names does not, by itself, indicate that they were acting in bad faith with regard to any of their individual registrations or website uses. Defendants also assert that the statements of Burgar have been taken out of context by the district court, and have been unfairly used to establish Northern Lights's bad faith.

Along with its inclusion of bad faith among the essential elements of the ACPA cause of action, Congress provided nine nonexhaustive guideposts that courts may use to divine whether

or not bad faith exists. See 15 U.S.C. §§ 1125(d)(1)(B)(i)(I)-(IX). In addition, the statute provides an "escape clause" to those whose conduct would otherwise constitute bad faith if the potential infringer "believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful." Id. § 1125(d)(1)(B)(ii). In this case, the district court determined that defendants' myriad explanations for their use of the northernlights.com site – e.g., as an experimental new business model, as a site for aurora borealis admirers, and as a compilation of businesses that contain the phrase "Northern Lights" – undermined Northern Lights's claim of subjective belief in fair use, and hence their entitlement to the "escape clause" of § 1125(d)(1)(B)(ii). See 97 F. Supp. 2d at 118-19. Additionally, the court concluded that the defendants' numerous registrations of domain names containing the trademarks of others, which defendants accomplished in some cases by creating fictional "fan clubs" so that they could present a mantle of legitimacy in their registration requests to NSI, represented powerful evidence of defendants' bad faith in operating the northernlights.com site. This conclusion of bad faith was reinforced, according to the district court, by defendants' history of disregarding cease-and-desist letters from legitimate trademark owners, and their apparent openness to sell the northernlight.com registration to the plaintiff at the right price. Id. at 119-20.

Based on our review of the record, we see no clear error in the district court's finding that defendants will likely be found to have acted in bad faith in operating the northernlights.com site.[11] Although defendants are correct in asserting that their multiple registrations alone are not dispositive of the bad-faith

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[11]The district court found that defendants' posting of a website at northernlights.com, rather than their initial domain-name registration, was the act that constituted bad-faith intent to profit in this case. See 97 F. Supp. 2d at 119 n.27.

issue, their well-established pattern of registering multiple domain names containing famous trademarks, such as rollingstones.com, evinrude.com, and givenchy.com, has been made highly relevant to the determination of bad faith by the list of factors in ACPA. See 15 U.S.C. § 1125(d)(1)(B)(i)(VIII) (noting as relevant factor "the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names"). Those facts are not clearly trumped by facts favoring defendants' side of the story, such as their use of northernlights.com as an e-mail domain name for several years prior to the dispute with the plaintiff and Burgar's initial resistance to the plaintiff's efforts to acquire defendants' domain-name registration. The district court's finding that defendants were not entitled to the "escape clause" also is not clearly erroneous; as the court found, defendants' oft-changing explanations for the purpose of the northernlights.com website evince a lack of subjective belief in the domain name's fair use.

Based on defendants' apparent modus operandi of registering domain names containing the famous trademarks of others in the hope that the famous trademark holder will be willing to pay to reclaim its intellectual-property rights, the district court reasonably concluded that defendants acted according to script in this case.[12] Accordingly, we determine that the district court did not err in finding that defendants will

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[12]Defendants claim that since they expected no revenue stream from the content on the northernlights.com website, they could not have acted with a bad-faith intent to profit. Based on their past practices, however, it is reasonable to conclude that defendants harbored a broader, more long-term notion of "profit." Instead, defendants likely hoped to cash in on the confusion surrounding the sponsorship of the websites by finding famous trademark holders willing to pay defendants to end the diversion of Internet traffic from their website to defendants' sites.

likely be found to have acted in bad faith in operating their northernlights.com website.

B. Retroactive Application of ACPA

Defendants also ask that we review the district court's legal determination that the retroactive application of ACPA to the facts of this case is permissible.[13] After reviewing the district court opinion and the parties' briefs, however, we find it unnecessary to reach this issue, as even if we were to decide the matter in defendants' favor, it would not provide an adequate basis for dissolving the injunction. This is so because the district court expressly stated that its decision to impose a preliminary injunction rested principally upon its finding that Internet users would likely be confused by the concomitant existence of the northernlight.com and northernlights.com marks. See 97 F. Supp. 2d at 121 ("Before turning to the balancing factors, I must emphasize the importance of the likelihood of confusion findings to the preliminary injunction calculus."). Because an ACPA violation does not require a showing of likely confusion,[14] the district court's decision to

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[13]As we recently noted in Hasbro, Inc. v. Clue Computing, Inc., 232 F.3d 1 (1st Cir. 2000) (per curiam), courts are split on the issue of whether recent Lanham Act provisions should be applied retroactively. Compare, e.g., Sporty's Farm, L.L.C. v. Sportsman's Market, Inc., 202 F.3d 489, 496-97 (2d Cir.) (concluding that ACPA should apply retroactively), cert. denied, 120 S. Ct. 2719 (2000) with Thomas & Betts Corp. v. Panduit Corp., 108 F. Supp. 2d 976 (N.D. Ill. 2000) (holding that new trade-dress provisions of Lanham Act should not be applied retroactively).

[14]As the district court noted, the "likelihood of confusion" test of trademark infringement is "more comprehensive" than the "identical or confusingly similar" requirement of ACPA, as it requires considering factors beyond the facial similarity of the two marks. 97 F. Supp. 2d at

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enter a preliminary injunction must have been based on its resolution of the non-ACPA claims, such as plaintiff's trademark-infringement claim. In their appeal, defendants' only argument on the merits that does not impugn the district court's ACPA findings concerns the determination that Northern Lights acted in bad faith. And as we have determined in Part III.A, supra, that finding was not clearly erroneous. Thus, no matter how we might resolve the ACPA-retroactivity issue – and we expressly eschew doing so at this time – our decision would fail to affect the validity of the injunction.[15]

In sum, we conclude that defendants have identified no basis for overturning the preliminary injunction already in place. We therefore affirm its issuance by the district court.

IV. First Amendment Overbreadth of the Injunction

Defendants argue that the scope of the preliminary injunction violates the First Amendment. We need not, however, consider that issue here, for although it may have been raised below, defendants did no more than obliquely refer to the issue when the district court held the critical hearing, and subsequently took part in the framing of the preliminary injunction. Because we do not find waiver, the issue can be argued in the trial on the merits.

Conclusion

Because the district court obtained personal jurisdiction over defendants when Burgar was served with process while in the forum state, we affirm, albeit on different grounds, the court's personal-jurisdiction finding. We find no basis for

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[14](...continued)
117.

[15]Defendants do claim that there were other "grossly unfair factual errors by the trial court" which constituted "an egregious result-driven pattern of prejudice" against them. But they have failed to specify those errors in their appellate briefs.

disturbing the court's determination of likelihood of success on the merits of plaintiff's suit, and therefore affirm those portions of the district court's opinion. Finally, while not precluding further consideration of the First Amendment issue at trial, we decline to resolve defendants' free-speech challenge to the scope of the injunction at this time.

Affirmed. Costs to appellee.

Appendix B.
United States Court of Appeals
For the First Circuit

No. 00-1641

NORTHERN LIGHT TECHNOLOGY, INC.,
Plaintiff, Appellee,
v.
NORTHERN LIGHTS CLUB, JEFFREY K. BURGAR, AND
641271 ALBERTA LTD., D/B/A NORTHERN LIGHTS CLUB,
Defendants, Appellants.

BEFORE
TORUELLA, Chief Judge,
SELYA, BOUDIN, STAHL, and LIPEZ, Circuit Judges.

ORDER OF COURT
Entered: January 30, 2001

The panel of judges that rendered the decision in this case having voted to deny the petitions for rehearing and the suggestions for rehearing en banc having been carefully considered by the judges of the Court in regular and active service and a majority of said judges not having voted to order that the appeals be heard or reheard by the Court en banc,

It is ordered that the petition for rehearing and the suggestion for rehearing en banc, be denied.

By the Court:
PHOEBE D. MORSE, Clerk

By: /s/ Janice M. O'Neil
Chief Deputy Clerk

cc: Messrs. Bonn, Pollack, Grimm, Gaeta, Lund

Appendix C.

Title 15, United States Code.

Sec. 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State

acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Remedies for dilution of famous marks

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous,

a court may consider factors such as, but not limited to -

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 1116 of this title unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary.

(d) Cyberpiracy prevention

(1) (A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person -

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that -

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B) (i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to -

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used,

or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of this section.

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2) (A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if -

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner -

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by -

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which -

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D) (i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall -

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

Appendix D.

FED. R. CIV. P. 4 Summons.

(a) Form.

The summons shall be signed by the clerk, bear the seal of the court, identify the court and the parties, be directed to the defendant, and state the name and address of the plaintiff's attorney or, if unrepresented, of the plaintiff. It shall also state the time within which the defendant must appear and defend, and notify the defendant that failure to do so will result in a judgment by default against the defendant for the relief demanded in the complaint. The court may allow a summons to be amended.

(b) Issuance.

Upon or after filing the complaint, the plaintiff may present a summons to the clerk for signature and seal. If the summons is in proper form, the clerk shall sign, seal, and issue it to the plaintiff for service on the defendant. A summons, or a copy of the summons if addressed to multiple defendants, shall be issued for each defendant to be served.

(c) Service with Complaint; by Whom Made.

(1) A summons shall be served together with a copy of the complaint. The plaintiff is responsible for service of a summons and complaint within the time allowed under subdivision (m) and shall furnish the person effecting service with the necessary copies of the summons and complaint.

(2) Service may be effected by any person who is not a party and who is at least 18 years of age. At the request of the plaintiff, however, the court may direct that service be effected by a United States marshal, deputy United States marshal, or other person or officer specially appointed by the court for that purpose. Such an appointment must be made when the plaintiff is authorized to proceed in forma pauperis pursuant to 28 U.S.C. § 1915 or is authorized to proceed as a seaman under 28 U.S.C. § 1916.

(d) Waiver of Service; Duty to Save Costs of Service; Request to Waive.

(1) A defendant who waives service of a summons does not thereby waive any objection to the venue or to the jurisdiction of the court over the person of the defendant.

(2) An individual, corporation, or association that is subject to service under subdivision (e), (f), or (h) and that receives notice of an action in the manner provided in this paragraph has a duty to avoid unnecessary costs of serving the summons. To avoid costs, the plaintiff may notify such a defendant of the commencement of the action and request that the defendant waive service of a summons. The notice and request

(A) shall be in writing and shall be addressed directly to the defendant, if an individual, or else to an officer or managing or general agent (or other agent authorized by appointment or law to receive service of process) of a

defendant subject to service under subdivision (h);

(B) shall be dispatch through first-class mail or other reliable means;

(C) shall be accompanied by a copy of the complaint and shall identify the court in which it has been filed;

(D) shall inform the defendant, by means of a text prescribed in an official form promulgated pursuant to Rule 84, of the consequences of compliance and of a failure to comply with the request;

(E) shall set forth the date on which the request is sent;

(F) shall allow the defendant a reasonable time to return the waiver, which shall be at least 30 days from the date on which the request is sent, or 60 days from that date if the defendant is addressed outside any judicial district of the United States; and

(G) shall provide the defendant with an extra copy of the notice and request, as well as a prepaid means of compliance in writing.

If a defendant located within the United States fails to comply with a request for waiver made by a plaintiff located within the United States, the court shall impose the costs subsequently incurred in effecting

service on the defendant unless good cause for the failure be shown.

(3) A defendant that, before being served with process, timely returns a waiver so requested is not required to serve an answer to the complaint until 60 days after the date on which the request for waiver of service was sent, or 90 days after that date if the defendant was addressed outside any judicial district of the United States.

(4) When the plaintiff files a waiver of service with the court, the action shall proceed, except as provided in paragraph (3), as if a summons and complaint had been served at the time of filing the waiver, and no proof of service shall be required.

(5) The costs to be imposed on a defendant under paragraph (2) for failure to comply with a request to waive service of a summons shall include the costs subsequently incurred in effecting service under subdivision (e), (f), or (h), together with the costs, including a reasonable attorney's fee, of any motion required to collect the costs of service.

(e) Service Upon Individuals Within a Judicial District of the United States.

Unless otherwise provided by federal law, service upon an individual from whom a waiver has not been obtained and filed, other than an infant or an incompetent person, may be effected in any judicial district of the United States:

(1) pursuant to the law of the state in which the district court is located, or in which service is

effected, for the service of a summons upon the defendant in an action brought in the courts of general jurisdiction of the State; or

(2) by delivering a copy of the summons and of the complaint to the individual personally or by leaving copies thereof at the individual's dwelling house or usual place of abode with some person of suitable age and discretion then residing therein or by delivering a copy of the summons and of the complaint to an agent authorized by appointment or by law to receive service of process.

(f) Service Upon Individuals in a Foreign Country.

Unless otherwise provided by federal law, service upon an individual from whom a waiver has not been obtained and filed, other than an infant or an incompetent person, may be effected in a place not within any judicial district of the United States:

(1) by any internationally agreed means reasonably calculated to give notice, such as those means authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents; or

(2) if there is no internationally agreed means of service or the applicable international agreement allows other means of service, provided that service is reasonably calculated to give notice:

(A) in the manner prescribed by the law of the foreign country for service in that country in

an action in any of its courts of general jurisdiction, or

(B) as directed by the foreign authority in response to a letter rogatory or letter of request; or

(C) unless prohibited by the law of the foreign country, by

(i) delivery to the individual personally of a copy of the summons and the complaint; or

(ii) any form of mail requiring a signed receipt, to be addressed and dispatched by the clerk of the court to the party to be served; or

(3) by other means not prohibited by international agreement as may be directed by the court.

(g) Service Upon Infants and Incompetent Persons.

Service upon an infant or an incompetent person in a judicial district of the United States shall be effected in the manner prescribed by the law of the state in which the service is made for the service of summons or other like process upon any such defendant in an action brought in the courts of general jurisdiction of that state. Service upon an infant or an incompetent person in a place not within any judicial district of the United States shall be effected in the manner prescribed by paragraph (2)(A) or (2)(B) of subdivision (f) or by such means as the court may direct.

(h) Service Upon Corporations and Associations. Unless otherwise provided by federal law, service upon a domestic or foreign corporation or upon a partnership or other unincorporated association that is subject to suit under a common name, and from which a waiver of service has not been obtained and filed, shall be effected:

(1) in a judicial district of the United States in the manner prescribed for individuals by subdivision (e)(1), or by delivering a copy of the summons and of the complaint to an officer, a managing or general agent, or to any other agent authorized by appointment or by law to receive service of process and, if the agent is one authorized by statute to receive service and the statute so requires, by also mailing a copy to the defendant, or

(2) in a place not within any judicial district of the United States in any manner prescribed for individuals by subdivision (f) except personal delivery as provided in paragraph (2)(C)(i) thereof.

(i) Service Upon the United States, and Its Agencies, Corporations, or Officers.

(1) Service upon the United States shall be effected

(A) by delivering a copy of the summons and of the complaint to the United States attorney for the district in which the action is brought or to an assistant United States attorney or clerical employee designated by the United States attorney in a writing filed with the clerk of the court or by

sending a copy of the summons and of the complaint by registered or certified mail addressed to the civil process clerk at the office of the United States attorney and

(B) by also sending a copy of the summons and of the complaint by registered or certified mail to the Attorney General of the United States at Washington, District of Columbia, and

(C) in any action attacking the validity of an order of an officer or agency of the United States not made a party, by also sending a copy of the summons and of the complaint by registered or certified mail to the officer or agency.

(2) Service upon an officer, agency, or corporation of the United States shall be effected by serving the United States in the manner prescribed by paragraph (1) of this subdivision and by also sending a copy of the summons and of the complaint by registered or certified mail to the officer, agency, or corporation.

(3) The court shall allow a reasonable time for service of process under this subdivision for the purpose of curing the failure to serve multiple officers, agencies, or corporations of the United States if the plaintiff has effected service on either the United States attorney or the Attorney General of the United States.

(j) Service Upon Foreign, State, or Local Governments.

(1) Service upon a foreign state or a political subdivision, agency, or instrumentality thereof shall be effected pursuant to 28 U.S.C. § 1608.

(2) Service upon a state, municipal corporation, or other governmental organization subject to suit shall be effected by delivering a copy of the summons and of the complaint to its chief executive officer or by serving the summons and complaint in the manner prescribed by the law of that state for the service of summons or other like process upon any such defendant.

(k) Territorial Limits of Effective Service.

(1) Service of a summons or filing a waiver of service is effective to establish jurisdiction over the person of a defendant

(A) who could be subjected to the jurisdiction of a court of general jurisdiction in the state in which the district court is located, or

(B) who is a party joined under Rule14 or Rule 19 and is served at a place within a judicial district of the United States and not more than 100 miles from the place from which the summons issues, or

(C) who is a subject to the federal interpleader jurisdiction under 28 U.S.C. § 1335, or

(D) when authorized by a statute of the United States.

(2) If the exercise of jurisdiction is consistent with the Constitution and laws of the United States, serving a summons or filing a waiver of service is also effective, with respect to claims arising under federal

law, to establish personal jurisdiction over the person of any defendant who is not subject to the jurisdiction of the courts of general jurisdiction of any state.

(l) Proof of Service.

If service is not waived, the person effecting service shall make proof thereof to the court. If service is made by a person other than a United States marshal or deputy United States marshal, the person shall make affidavit thereof. Proof of service in a place not within any judicial district of the United States shall, if effected under paragraph (1) of subdivision (f), be made pursuant to the applicable treaty or convention, and shall, if effected under paragraph (2) or (3) thereof, include a receipt signed by the addressee or other evidence of delivery to the addressee satisfactory to the court. Failure to make proof of service does not affect the validity of the service. The court may allow a proof of service to be amended.

(m) Time Limit for Service.

If service of the summons and complaint is not made upon a defendant within 120 days after the filing of the complaint, the court, upon motion or on its own initiative after notice to the plaintiff, shall dismiss the action without prejudice as to that defendant or direct that service be effected within a specified time; provided that if the plaintiff shows good cause for the failure, the court shall extend the time for service for an appropriate period. This subdivision does not apply to service in a foreign country pursuant to subdivision (f) or (j)(1).

(n) Seizure of Property; Service of Summons Not Feasible.

(1) If a statute of the United States so provides, the court may assert jurisdiction over property. Notice to claimants of the property shall then be sent in the manner provided by the statute or by service of a summons under this rule.

(2) Upon a showing that personal jurisdiction over a defendant cannot, in the district where the action is brought, be obtained with reasonable efforts by service of summons in any manner authorized by this rule, the court may assert jurisdiction over any of the defendant's assets found within the district by seizing the assets under the circumstances and in the manner provided by the law of the state in which the district court is located.

(3) Supreme Court, U.S.
FILED
001651 APR 30 2001
OFFICE OF THE CLERK

No.

IN THE

Supreme Court of the United States

NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

APPENDIX TO THE PETITION FOR WRIT OF CERTIORARI (VOLUME II)

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[Appendix F shall be submitted separately,
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shall be included as an Appendix only with leave].

Appendix E.

United States District Court for the District of Massachusetts

NORTHERN LIGHT TECHNOLOGY, INC., Plaintiff,
v.
NORTHERN LIGHTS CLUB, et al., Defendants.

No. Civ. A. 99-11664-DPW.

March 31, 2000.

Bernard J. Bonn, III, Barry S. Pollack, Dechert, Price & Rhoads, Boston, for Plaintiff.

Eric C. Grimm, Grand Rapids, MI, Theodore A. Lund, Frank N. Gaeta, Gaeta, Courville & Lund, LLP, Boston, MA, Defendants.

MEMORANDUM AND ORDER

WOODLOCK, District Judge.

Plaintiff Northern Light Technology Incorporated, which owns the NORTHERN LIGHT (R) trademark, alleges defendants Northern Lights Club, Jeff Burgar, and 641271 Alberta Ltd. infringed the NORTHERN LIGHT (R) trademark, cyberpirated the NORTHERN LIGHT (R) trademark, and unfairly competed with the Plaintiff through the use of a World

Wide Web site at the address of www.northernlights.com.[1] A number of motions are before me.

The Plaintiff moves for a preliminary injunction, to strike an affidavit, for an order holding the Defendants in contempt, and to compel documents. The Defendants move to dismiss the complaint on the basis this court lacks personal jurisdiction over the Defendants pursuant to Fed.R.Civ.P. 12(b)(2), to dismiss the complaint for failure to state a claim pursuant to Fed.R.Civ.P. 12(b)(6), to impose Fed.R.Civ.P. 11 sanctions, for reconsideration of the preliminary injunction, and to compel various discovery requests.

I. BACKGROUND

A. *The Internet*

The Internet is a giant electronic network which connects the smaller networks of the world. The Internet was developed by the Department of Defense's Advanced Research Project Agency 25 years ago in order to link the computer systems of universities, government agencies, and other research organizations. Since then, the activity generated by the Internet, as well as the size of the Internet itself, has grown exponentially. Today, the Internet serves approximately 90 million individuals, linking those persons (or, more accurately, their computers) through global telecommunication lines. The

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[1]Plaintiff's First Amended Complaint filed Dec. 14, 1999 includes the following counts: Trademark Cyberpiracy, 15 U.S.C. § 1125(d) (Count I); Trademark Infringement Under the Lanham Act, 15 U.S.C. § 1114(1) (Count II); Federal Unfair Competition and False Designation of Origin under the Lanham Act, 15 U.S.C. § 1125(a) (Count III); Trademark Infringement Under Massachusetts Common Law (Count IV); and Unfair Trade Practices, Mass. Gen. Laws ch. 93A §§ 2, 11 (Count V). Plaintiff in its First Amended Complaint dropped the following counts included in the original Complaint filed August 6, 1999: Dilution under the Lanham Act, 15 U.S.C. § 1125(c) (Count III); Unfair Competition under Massachusetts Common Law (Count IV); and Dilution under Massachusetts Law, Mass. Gen. Laws ch. 110B § 12 (Count VI).

World Wide Web is one part of the Internet which allows for the display of graphic materials, photos, text and audio. Individuals around the world can easily access and interact with the World Wide Web. Information is "published" on the Internet by any individual working with the proper software in their home or business. Because of the ease of producing the "Web pages" or "Web sites," a vast array of information has accumulated on the World Wide Web. Users access such information by either typing in an address or using any of several "search engines," software and database architecture that explores the Web, that seek to locate particular text requested by the user. World Wide Web addresses take two forms. A unique numeric address identifies each site along with a unique corresponding alphanumeric address, known as a "domain name." Hasbro v. Clue Computing, Inc., 994 F.Supp. 34, 36-37 (D.Mass.1997) (citations omitted); *see generally* ACLU v. Reno, 929 F.Supp. 824, 830-38 (E.D.Pa.1996), aff'd, 521 U.S. 844, 117 S.Ct. 2329, 138 L.Ed.2d 874 (1997).

In order to avoid overlapping use of the same domain name, the federal government originally designated a single private company, Network Solutions, Inc. ("NSI"), to act as the exclusive registrar of domain names.[2] (Suess Aff. of August 5, 1999 ("Suess Aff.") § 5.). NSI basically granted domain names on a first-come, first-serve basis. (Suess Aff. § 6.).

Domain names are organized on two levels. The first level domain name indicates the type of organization, e.g. ".edu" for educational institutions, ".com" for commercial organizations, ".gov" for government organizations. In addition to the suffix, one other character string, chosen by the creator, makes up a unique specific address, or the domain name. This poses a problem where several different companies conduct businesses

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[2]Other organizations are now permitted to register domain names, but the dispute in this case revolves around registrations with NSI.

under the same mark, which each would like to use. This problem has been further amplified by individuals who capitalize upon the issue, trying to "scoop up" available Web sites that might later be in demand by large companies. These individuals have been termed "cyber-squatters." Hasbro, 994 F.Supp. at 37. This case contains allegations of cybersquatting, also known as cyberpiracy. In addition, this case contains allegations of reverse hijacking, the practice of using intellectual property rights to extort a domain name from another.

One final point, although the discussion of domain names to this point has been limited to their use in identifying websites, domain name addressing also permits the addressing of email. Just as a domain name address can direct a browser user to a website, the domain name address can direct email. (Burgar Aff. of Aug. 20, 1999 ("Burgar Aff.") § 9.)

B. *Plaintiff*

Plaintiff Northern Light Technology, LLC, a Cambridge, Massachusetts based firm, provides customers with a World Wide Web search engine. (Seuss Aff. of August 5, 1999 ("Seuss Aff.") § 2 and Ex. B.) The search engine can currently be accessed on the World Wide Web at www.northernlight.com. (Suess Aff. § 2.) The Plaintiff registered northernlight.com with the NSI on September 16, 1996.[3] (Suess Aff. Ex. G.) The NORTHERN LIGHT (R) search engine first began operating on the World Wide Web in August of 1997. (Seuss Dep. 343, Ex. 19 of Defs.' Exs. of Dec. 22, 1999.) At the time of the filing of this suit, the web page

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[3]The Plaintiff has also registered or acquired several hundred other domain names such as fedgovsearch.com, nlresearch.com, and supportdesk.net. (Ex. 3 of Defs.' Exs. of Dec. 22, 1999.)

located at www.northernlight.com had the following layout.[4] *See* Seuss Aff. Ex. A (screen shot of www.northernlight.com).

The screen shot shows three main regions. First, running down theleft side of the screen from top to bottom are (1) the Northern Light logo, a rectangular box--slightly greater height than width--with the top three quarters of the box containing an image of a clipper ship[5] and the bottom quarter containing the words "Northern Light;" (2) a button with the word "Home" on it (this button appears highlighted because the screen shot is of the home page); (3) a button with the word "Help Center" on it; (4) a button with the word "Accounts" on it; (5) a button with the word "Company" on it.[6]

The second region runs along the top of the screen. In this region are a series of what look like folder tabs. From left to right on separate tabs are the words "Search," "Power," "Industry," "News," "WEFA," "Investext," and "Publication." These seem to be to allow users to jump to other pages associated with the words written on each tab. The "Search" tab is highlighted.

The final region occupies the majority of the screen. It is enclosed on the top and left sides by a shadowed line which makes the region appear to be the surface of a file folder. The tabs mentioned above run just above the top line to further

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[4]The content and layout of the web page have changed since the filing of the suit. Nonetheless, the screen shot described in the main text does not differ dramatically from the current incarnation of the Plaintiff's web page.

[5]The significance of the clipper ship is that Northern Light, the company, was named after the Northern Light, a clipper ship built in 1851. (Def.'s Mem. re: Prelim. Injunc. filed Aug. 23, 1999. Ex. 1.)

[6]These buttons appear to allow a user to jump to other pages associated with the topic listed on the button.

enhance the folder metaphor. One difference from conventional folders is that the screen folder has greater height than width.

In this third region, at the top are the words "Search for." Immediately below these words is a dialog box where a user can type a word or search phrase. To the right of the dialog box are two more buttons, one that says "Search," and another that says "Help." This search dialog box is the most prominent single feature on the screen.

Beneath the dialog box and occupying the majority of this region, are two columns describing numerous special features such as Investext Search, which provides research from stock market analysts; and Custom Search Folders, which allows for results to be dynamically organized, together with notice of Northern Light's receipt of PC Magazine's Editor's Choice Award for Advanced Searching. Finally, beneath the two columns is a single centered column that suggests to users that they should make Northern Light their default search service, provides a link to connect to information about advertising, and notifies a user of Northern Light's copyright.

In addition to registering the domain name northernlight.com, the Plaintiff also trademarked the phrase "NORTHERN LIGHT." The plaintiff filed its federal registration for this trademark on September 23, 1996. (Suess Aff. Ex. F.) The trademark was first used in commerce on August 15, 1997. (Seuss Aff. Ex. F.) The trademark was issued by the Patent and Trademark office on February 23, 1999. (Seuss Aff. Ex. F.)

C. *Defendants*

Defendant Jeff Burgar is a resident of High Prairie, Alberta, Canada. (Bu gar Aff. § 2.) Burgar is the president and principal shareholder of defendant 641271 Alberta, Ltd., an Alberta Corporation with its principal place of business in High Prairie, Alberta, Canada. (Burgar Aff. § 3.) In addition, Burgar is the president of defendant Northern Lights Club ("Club"), an unincorporated association located in High Prairie, and the

entity that officially registered the allegedly infringing domain name northernlights.com.[7] (Burgar Aff. § 3; Suess Aff. Ex. H; Burgar Dep. 43, Pollack Aff. Ex. A.)

In addition to 641271 Alberta, Ltd. and Club, Burgar has numerous, and often ill-defined associations with other entities located in the same building in High Prairie, Alberta, Canada. Some of these entities include Internet North, South Peace News, Lakeside Leader, and Flairmail. To give some idea of the convoluted nature of the relations, Justin Lumsden, a supervisee of Burgar, primarily does work for Internet North, an internet service provider, but Lumsden is paid by South Peace News, a newspaper, and the paycheck is delivered by Mary Burgar, Defendant Burgar's wife. (Lumsden Aff. § 2; Lumsden Dep. 5.) Burger manages the day-to-day activities of both Internet North and FlairMail, a vanity email service. (Lumsden Dep. 25; Burgar 2nd Supp. Aff. § 2.) FlairMail is owned by Lakeside Leader, a newspaper. (Burgar Dep. 55.) Burgar believes Lakeside Leader is owned by his wife. (Burgar Dep. 55.) Burgar licenses domain names that he has registered either by himself, through 641271 Alberta, Ltd., or through clubs like the Northern Lights Club or the Bill Elliot Club to FlairMail. Nonetheless, all advertising money received from website advertising is paid to Internet North. (Burgar Dep. 52.)

Burgar as president of 641271 Alberta, Ltd. used the Northern Lights Club to register the domain name northernlights.com with NSI on October 31, 1996. (Suess Aff. Ex. H.) As of August 5, 1999, Burgar was listed on the registration as one of the contacts, and the Club's address was

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[7]The membership in Northern Lights Club is unclear. Burgar states in his August 20, 1999 affidavit that the Northern Lights Club members all reside in Alberta, Canada. (Burgar Aff. § 3.) But, in his deposition, Burgar states both that there are no members and that one could consider the entities listed on the northernlights.com web site to be members. (Burgar Dep. 41-42, Pollack Aff. Ex. A.)

listed as 1350 East Flamingo Road, # 57, Las Vegas, NV 89119, US. (Seuss Aff. Ex. H.) Shortly after registration, northernlights.com was licensed to FlairMail.

Flairmail is a vanity email service. As noted above, a domain name can also function to direct email. FlairMail operates by collecting, either through registration or licensing, thousands of domain names and then permitting users to both select their own unique handles and combine it with one of Flairmail's domain names. For instance, among the hundreds of domain names FlairMail offers are baseballcrazy.com and bassangler.com. (www.flairmail.com/domains.html.) Therefore, a Flairmail user could register for an email such as litigant@baseballcrazy.com.

Of the hundreds of domain names available at Flairmail, northernlights.com is and has been available since shortly after its registration in October of 1996. Approximately 112 people use northernlights.com for their email. (Pollack Aff. Ex. CC.) In addition, several of the FlairMail domain names suggest associations with Massachusetts: redsox1.com, goredsox.com, patriots1.com, gopatriots.com, goceltics.com, bruins1.com, massachusetts1.com, and thebaystate.com. Approximately seventy-three people use one of the domain names associated with Massachusetts. However, no records exist indicating whether or not any FlairMail users live in Massachusetts. (Burgar 2nd Supp. Aff. § 3.)

Burgar is also the contact person for thousands more domain names. He has received cease and desist letters for a number of domain names including RollingStones.com, hewlettpackard.com, derekjeter.com, tyrabanks.com, and highsociety.com among others. (Pollack Aff. Exs. C-Y.) Burgar does not check for trademarks before registering the domain names. (Burgar Dep. 106, Pollack Aff. Ex. A.) Burgar, however, asserts neither he nor the other defendants are in the business of selling domain names; neither 641271 Alberta, Ltd. nor Club has ever sold a domain name, and Burgar has sold

only two. (Burgar Aff. § 23.) Burgar has been involved in other suits related to the domain names he owns.

Burgar asserts that none of the Defendants have significant connections to Massachusetts. Club does not have any members located in Massachusetts. (Burgar Aff. § 3.) None of the Defendants registered in Massachusetts to transact business, employed Massachusetts residents, or paid Massachusetts taxes. (Burgar Aff. § 4.) None have offices, real estate, bank accounts, personal property, sales representatives, or postal address in Massachusetts. (Burgar Aff. § 4.) Furthermore, because FlairMail is a web-based email, all the email sent to FlairMail users is stored on servers located in Alberta even though it may be accessed from anywhere. (Lumsden Aff. § 17, Defs.' Mem. re: Restraining Order filed September 30, 1999 Ex. 14.) FlairMail and the website northernlights.com receive or used to receive revenue from advertising agencies that work for advertisers whose advertisements appear when users visit the sites. (Burgar 2nd Supp. Aff. § 9.) These advertising agencies are located mainly in Canada and none are located in Boston.[8] (Burgar 2nd Supp. Aff. § 9.)

To this point, I have mainly been discussing the use of northernlights.com as an email domain name. This case, however, arises primarily from the establishment of a web site in April of 1999 at the address www.northernlights.com. (Winston Aff. § 5.) At the time of the filing of this suit, the web page located at www.northernlights.com had the following layout. *See* Suess Aff. Ex. I (screen shot of www.northernlights.com).

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[8]Neither side has submitted evidence as to whether any of the advertisers themselves are located in Massachusetts. The Plaintiff notes that one of the advertisers, jobs.citysearch.com, offers career opportunities in Massachusetts and another is VISA, the credit card company. (Suess Supp. Aff. § 6.) The Plaintiff, however, does not identify on which web site these advertisers can be found.

The screen shot shows that at the top of the page, there is a rectangular box, significantly wider than tall, that is blurred. Below this box is another box that is both slightly taller and wider than the first box. In this second box, written in large letters and right justified is "NorthernLights.com." In the left quarter is an image of the Aurora Borealis or Northern Lights. Beneath this box, the page divides into two columns.

At the top of the right column in bold is "Search NorthernLights.com," and, beneath this, is a dialog box with a button to the box's right on which the word "Search" is printed. However, when a user attempted to use the search function, s/he received the message "[t]here are currently not enough listings to implement a search function." (Seuss Aff. § 12.) In the same column but below the dialog box and "Search" button, is a list of businesses and institutions with the phrase "Northern Light" in each one's name. Northern Light Search Engine is listed third down in the list.

In the left column beneath the NorthernLights.com box, are the following items from top to bottom: (1) a link to get information on listing a Northern Lights service on this page, (2) a featured listing, which in this screen shot is Northern Light CoDesign, (3) an image link to Flairmail, (4) a section entitled Northern Lights Community that contains links to Flairmail, CityLive, and Celebrity 1000, and (5) a section indicating the web page's copyright.

D. *Interactions Among Plaintiff and Defendants*

David Suess, the Chief Executive Officer of the Plaintiff, asserts that, in the summer of 1996, he contacted Burgar to request he sell northernlights.com.[9] (Suess Aff. §§ 1, 14.) Suess further asserts that Burgar declined Suess's offer because

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[9]I note that while Suess asserts this occurred in the summer of 1996, northernlights.com was not registered until October 31, 1996. (Suess Aff. Ex. H.)

Burgar intended to tie up a large number of domain names, wait for them to become more valuable, and then sell them at inflated prices. (Suess Aff. § 14.) Burgar denies this exchange ever took place. (Burgar Aff. § 30.)

On March 2, 1999, shortly after the publication of a USA Today article in which the newspaper misprinted the Plaintiff's web address as www.northernlight *s*.com (emphasis added), Victoria Winston, the Plaintiff's Director of Marketing, contacted Burgar via email to see if he was interested in selling the domain name northernlights.com. (Winston Aff. Ex. A; Winston Dep. 34, Exs. to Def.'s Supp. Mem. re: Prelim. Injunc. filed Dec. 22, 1999 Ex. 15.) Burgar responded on the same day with the following message:

> Hello Victoria,
>
> We have had a few instances over the past year of people looking for your site and we forwarded them to you.
>
> I will have to check our stats which may indicate the number of users looking for your site.
>
> At the moment we are not contemplating selling any of our domain names.
>
> However, we DO have a business model demonstration in the works using specific domain names you will likely want to take advantage of.
>
> We anticipate usage will be free.
>
> We expect to have this available for viewing this week.
>
> It may not be the most satisfactory for you, but I think it will assist you. I am not totally familiar with your business but we are looking for some inexpensive search engine technology which can be used on the web. Do you have such for sale or lease?...
>
> Jeff

(Winston Aff. Ex. A.) Winston then responded that she understood the Defendants were not interested in selling the domain name, that she was confused regarding the business model Burgar referenced, and that the Plaintiff has only

licensed its search technology in larger deals. (Winston Aff. Ex. A.)

Burgar wrote to Winston on March 3, 1999. He notified Winston that he was building the demo page for the new business model and he would forward the web address to Winston when he was done. Furthermore, he indicated he was willing to consider the Plaintiff's search technology if it was available for between $500,000 and $1,000,000. (Winston Aff. Ex. A.) Finally, in the last email of the series, Winston told Burgar that the Plaintiff does not sell its search technology and that she looked "forward to being referenced to your site when it is up and available." (Winston Aff. Ex. A.)

Winston asserts this was the only communication she had with Burgar. (Winston Aff. § 2.) Burgar alleges that he and Winston spoke by telephone. (Burgar Aff. § 26.) He says that during this conversation he explained to Winston his new business model whereby entities could share the relatively scarce prime domain names by using the web sites located at the prime domain names as clearinghouses. During this discussion, Burgar says Winston said this sounded like a workable solution for the Plaintiff. (Burgar Aff. §§ 26-27.)

The Defendants posted the northernlights.com web site in April 1999. (Winston Aff. § 5.) Once this occurred, the Plaintiff began to get approximately 300 referrals from the new web site. This number later grew to several thousand referrals per day. (Winston Aff. § 5.)

On July 14, 1999, the Plaintiff sent Burgar a cease and desist letter. (Burgar Aff. Ex. 3.) Correspondence ensued. (Burgar Aff. Ex. 3.) On July 29, 1999, the Plaintiff contacted NSI to initiate domain name dispute proceedings. (Burgar Aff. Ex. 3.) NSI refused to disable northernlights.com because it differed by an "s" from the Plaintiff's trademark.

On August 6, the Plaintiff filed this law suit and sought interlocutory relief. A preliminary injunction was issued requiring the Defendants to black out their northernlights.com

web site except for links to FlairMail, the Plaintiff's search engine, and a list of the businesses that were previously listed at the web site.

II. JURISDICTION

The Plaintiff argues that this court has specific personal jurisdiction over the Defendants or *in rem* jurisdiction based upon the newly-passed Anticybersquatting Consumer Protection Act, P.L. 106-113.

A. *Specific Personal Jurisdiction*

"Personal jurisdiction implicates the power of a court over a defendant." Foster-Miller v. Babcock & Wilcox Canada, 46 F.3d 138, 143 (1st Cir.1995). In order to obtain specific personal jurisdiction in this case, the plaintiff must satisfy two conditions: (1) the Massachusetts long-arm statute must grant jurisdiction over each defendant, and (2) the exercise of jurisdiction must comport with Constitutional Due Process. *See* id. at 144.

1. Massachusetts Long-Arm Statute

The relevant portions of the Massachusetts long-arm statute provide

> A court may exercise personal jurisdiction over a person, who acts directly or by an agent, as to a cause of action in law or equity arising from the person's
>
> (a) transacting any business in this commonwealth;
>
> . . . . .
>
> (c) causing tortious injury by an act or omission in this commonwealth;
>
> (d) causing tortious injury in this commonwealth by an act or omission outside this commonwealth if he regularly does or solicits business, or engages in any other persistent course of conduct, or derives substantial revenue from goods used or consumed or services rendered, in this commonwealth;
>
> . . . . .

Mass. Gen. Laws ch. 223A § 3. Plaintiff argues that jurisdiction arises over the Defendants based upon § 3(a), (c), and (d).

a. § 3(a) – In order to find jurisdiction under § 3(a), a defendant must have transacted business in Massachusetts and the plaintiff's claim must have arisen from the transaction of such business. Tatro v. Manor Care, 416 Mass. 763, 767, 625 N.E.2d 549 (1994). Although "transacting any business" has been construed broadly, "an isolated (and minor) transaction with a Massachusetts resident may be insufficient." Id. "[G]enerally the purposeful and successful solicitation of business from residents of the Commonwealth, by a defendant or its agent, will suffice to satisfy this requirement." Id. (finding jurisdiction where defendant hotel had direct billing arrangement with a number of Massachusetts businesses and hosted events for seven Massachusetts businesses); *see also* Gary Scott International, Inc. v. Baroudi, 981 F.Supp. 714, 716 (D.Mass.1997) (basing jurisdiction on defendant entering contract with Massachusetts retailer for twelve cigar humidors, solicitation of business on Internet, and expressed intent to continue business in Massachusetts); Digital Equip. Corp. v. AltaVista Technology, Inc., 960 F.Supp. 456, 465-66 (D.Mass.1997) (taking jurisdiction because contract formed with Massachusetts company and sales made to Massachusetts residents). In the present case, the Plaintiff has not shown that any of the Defendants has attempted to solicit business and succeeded.

Unlike the cases cited above, none of the Defendants entered into a commercial relation with a Massachusetts resident. The Plaintiff has not shown that any of the businesses listed on the northernlights.com web page was from Massachusetts, except the Plaintiff itself, or that any of the advertising agencies or advertisers was from Massachusetts. In addition, the Plaintiff has not established that any users of

FlairMail were Massachusetts residents.[10] Finally, even assuming that FlairMail did transact business with Massachusetts residents, the Plaintiff has not satisfactorily tied FlairMail to any of the Defendants for purposes of jurisdiction. The evidence in the record only succeeds in proving Burgar is the manager of FlairMail; this is not a sufficient relationship to consider FlairMail's transactions with Massachusetts.

b. § 3(c) – The Plaintiff has, however, established a prima facie case for jurisdiction under § 3(c). Judge Gertner in Digital Equip. Corp. v. AltaVista Technology, Inc., 960 F.Supp. 456, 466-67 (D.Mass.1997), convincingly analogized Internet infringement cases to cases involving misrepresentations communicated to a Massachusetts resident because in both cases the harm arises from the communication itself:

> Using the Internet under the circumstances of this case is as much knowingly "sending" into Massachusetts the allegedly infringing and therefore tortious uses of [the Plaintiff's] trademark as is a telex, mail, or telephonic transmission; the only difference is that the transmission is not "singularly" directed at Massachusetts, in the way that a letter addressed to this state, or a telephone or fax number with a Massachusetts area code would be. But [the Defendant] "knows" that its Web-site reaches residents of Massachusetts who choose to access it, just as surely as it "knows" any letter or telephone call is likely to reach its destination. And it presumably "knows" the contents of its Web-site.... It not only took no steps to prevent the alleged infringements from reaching this state's residents--

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[10]The fact that a number of the FlairMail domain names had associations with Massachusetts does not prove that FlairMail in fact transacted business with any Massachusetts residents.

> assuming there were steps to take--it plainly intended to market its wares here.

In the current case, the Plaintiff has established a colorable claim of trademark infringement. *See infra* section III.A. Furthermore, the Defendants have made little or no effort to curtail their allegedly infringing activity. By letter dated July 14, 1999, the Plaintiff notified the Defendants of their allegedly infringing activities, and, in particular, the confusion caused by the existence of a search function and a link to Northern Light on the web page www.northernlights.com. (Burgar Aff. Ex. 3.) While the Defendants moved the reference to Northern Light from the featured listing, they continued to display the reference and the nonfunctional search function. (Suess Aff. Ex. I.) Finally, several points indicate the Defendants plainly intended to market their new venture, www.northernlights.com, in Massachusetts. First, Burgar said he wanted Massachusetts residents to use his new business model:

> A: If my venture was successful I would hope everybody in the United States and everybody in the world would use my service....
>
> Q: ... you would have had users in Massachusetts if it were successful?
>
> A: In all likelihood.

(Burgar Dep. at 252, Pollack Aff. Ex. A.) Second, the site itself, which is accessible throughout Massachusetts, invites users to inquire about both being listed at the site and advertising on the site. Third, in correspondence with Virginia Winston, Burgar solicited Northern Light: "However, we DO have a business model demonstration in the works using specific domain names you will likely want to take advantage of." (Burgar email to Winston Mar. 2, 1999, Winston Aff. Ex. A.) Given entrance of the allegedly infringing material into Massachusetts, the Defendants' knowledge of its potentially infringing nature, and their goal of doing business with Massachusetts residents, § 3(c) is satisfied.

c. § 3(d) – The question under § 3(d) is whether the Defendants activities constitute "regularly solicit[ing]" or "engage[ing] in any other persistent course of conduct." I find that the Defendants have regularly solicited business in Massachusetts. Their web site operates twenty-four hours a day, seven days a week. Furthermore, the web site is not merely a passive one; it seeks to entice users either to post their own link on the site or to advertise on the site. Finally, via the web site and other communications, the Defendants attempted to do business with the Plaintiff. *See* Hasbro, Inc. v. Clue Computing, Inc., 994 F.Supp. 34, 43-44 (D.Mass.1997) (holding § 3(d) satisfied because web site solicits business in Massachusetts); Digital Equip. Corp. v. AltaVista Technology, Inc., 960 F.Supp. 456, 467 (D.Mass.1997) (finding § 3(d) met because web site plainly solicits business).

2. Constitutional Due Process

> In order to establish personal jurisdiction over a non-resident defendant in a way consistent with Constitutional due process, the defendant must either have "continuous and systematic activity, unrelated to the suit, in the forum state," Foster-Miller, Inc., 46 F.3d at 144, or certain "minimum contacts with the forum state so that the exercise of jurisdiction does not offend 'traditional notions of fair play and substantial justice.' " International Shoe v. Washington, 326 U.S. 310, 316, 66 S.Ct. 154, 90 L.Ed. 95 (1945) (quoting Milliken v. Meyer, 311 U.S. 457, 61 S.Ct. 339, 85 L.Ed. 278 (1940)). The former confers general jurisdiction; the latter, specific. *See* Burger King Corp. v. Rudzewicz, 471 U.S. 462, 472-73 & n. 15, 105 S.Ct. 2174, 85 L.Ed.2d 528 (1985).

Hasbro, Inc. v. Clue Computing, Inc., 994 F.Supp. 34, 44 (D.Mass.1997). In this case, the Defendants contacts with Massachusetts are too minimal to merit general jurisdiction.

In evaluating "minimum contacts", three distinct components must be considered: relatedness, purposeful availment, and reasonableness. Id.

a. Relatedness – "[T]he claim underlying the litigation must directly arise out of, or relate to, the defendant's forum-state activities." United Elec., Radio, and Mach. Workers v. 163 Pleasant St. Corp., 960 F.2d 1080, 1089 (1st Cir.1992) ("United "). The Defendants' potentially tortious acts all arise from the Defendants' publishing of a web site in Massachusetts, thus, satisfying this element. Hasbro, 994 F.Supp. at 44.

b. Purposeful Availment – "[T]he defendant's in-state contacts must represent a purposeful availment of the privilege of conducting activities in the forum state, thereby invoking the benefits and protections of that state's laws and making the defendant's involuntary presence before the state's courts foreseeable." United, 960 F.2d at 1089.

The mere existence of a web site is not sufficient to show purposeful availment. *See* GTE New Media Services Inc. v. BellSouth Corp., 199 F.3d 1343, 1349 (D.C.Cir.2000) ("personal jurisdiction surely cannot be based solely on the ability of District residents to access defendants' websites"); Mink v. AAAA Dev. LLC, 190 F.3d 333, 336-37 (5th Cir.1999) (denying jurisdiction where defendant's only contact with state was passive web site); Cybersell, Inc. v. Cybersell, Inc., 130 F.3d 414, 419 (9th Cir.1997) (same). Instead, some expression of a desire to do business in the pertinent state must exist.

In Panavision, International, L.P. v. Toeppen, 141 F.3d 1316 (9th Cir.1998), the California owners of the marks PANAVISION (R) and PANAFLEX (R) sued an Illinois man for trademark dilution in California. The defendant had registered the domain names panavision.com and panaflex.com, posted pictures of Pana, Illinois on one web site and the word "hello" on the other, and attempted to sell the domain names to Panavision. The Court found that the Defendant had satisfactorily manifested an intention to do business in

California by attempting to extort money from the California owners. Id. at 1322.

In Hasbro, Inc. v. Clue Computing,Inc., 994 F.Supp. 34 (D.Mass.1997), Hasbro brought suit in Massachusetts against a Colorado company for its alleged infringement of Hasbro's registered trademark CLUE (R). The Colorado company was found to have purposely availed itself of Massachusetts because in one year 33-50% of its income was derived from a Massachusetts company, the defendant advertised this association on its web site, and it took no measures to avoid contacts with Massachusetts. Id. at 44-45.

In Digital Equip. Corp. v. AltaVista Technology, Inc., 960 F.Supp. 456 (D.Mass.1997), Judge Gertner focused upon the defendant's licensing agreement with the plaintiff, a Massachusetts corporation, and the fact the defendant had made sales via the World Wide Web to Massachusetts customers to grant jurisdiction.

In the instant litigation, I find that the Defendants have expressed an intention to do business in Massachusetts. First, their web site provides links for both users interested in posting their "Northern Light" organization on the web site and those who want to advertise on the web site.[11] Second, the Defendant's knew that their allegedly infringing web site was entering Massachusetts, Northern Light's home. Third, on two occasions, the Defendants attempted to do business with the Plaintiff regarding the World Wide Web: the Defendants attempted both to license the Plaintiff's search technology and to entice the Plaintiff to take part in the Defendants' "new business model."

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[11]If this had been the extent of the contacts with Massachusetts, I do not know whether jurisdiction would have been appropriate.

> c. Reasonableness –
> In assessing reasonableness, the Court has directed focus on five gestalt factors: (1) the defendant's burden in appearing in the court; (2) the forum state's interest in hearing the suit; (3) the plaintiff's convenience and interest in effective relief; (4) the judicial system's interest in obtaining the most effective resolution of the controversy; and (5) the common interests of all interested states in promoting substantive social policies.

Hasbro, 994 F.Supp. at 45. The first factor clearly weighs in favor of the Defendant because traveling from Alberta, Canada requires significant expenditures of time and money. Nevertheless, its weight is diminished unless a party can demonstrate some kind of special or unusual burden. *See* Pritzker v. Yari, 42 F.3d 53, 64 (1st Cir.1994). In this case, while Burgar argues unusual circumstances exist because he must travel three and a half hours before reaching an airport and the suit may interfere with his ability to function as a public official, I do not believe these are sufficient to grant this factor generous weight. I am aware of Burgar's difficulties and will keep them in mind when scheduling matters.

The second factor, the interest of Massachusetts in hearing this suit weighs in favor of the Plaintiff. The Plaintiff is located in Massachusetts, and the alleged infringement is likely to have its most significant effects here. "Massachusetts has an interest in preventing trademark infringement against those subject to the protections and requirements of its laws." Hasbro, 994 F.Supp. at 45.

The third factor, the convenience of the plaintiff, weighs in favor of the Plaintiff. The Plaintiff is located in Cambridge, Massachusetts, and many of the witnesses and much of the evidence will come from this area.

The fourth factor, the judicial systems' interest in obtaining the most efficient resolution of this case, is generally considered

"a wash." Nowak v. Tak How Investments, Ltd., 94 F.3d 708, 718 (1st Cir.1996). In this case, this factor favors either neither party or the Plaintiff. At this point, we have moved along considerably in this case. If I were to deny jurisdiction, the case would have to begin anew in Virginia, Nevada, Canada or possibly elsewhere. My belief is that the Plaintiff has other venues open to it but sending it there now would not be a prudent use of judicial resources.

The final factor concerns the relative interests of the interested states--in this case, the United States, Canada, Alberta, and Massachusetts. On the one hand, I am concerned about taking jurisdiction over a Canadian citizen who truly has "minimum contacts" with Massachusetts, but I am assuaged by the fact that, in general, the two countries share similar views regarding the importance of trademark protection. (Def.'s Mem. re: Recon. Personal Juris. filed at 70.) Therefore, I believe that at best this factor is a wash as well.

Weighing the Gestalt factors together, I find specific personal jurisdiction reasonable.[12]

B. *Transfer of Venue and Comity*

As an alternative to the Defendants' jurisdiction arguments, the Defendants argue that this action should be dismissed on the bases of comity and/or *forum non conveniens* in order for it to be brought in Alberta, Canada.[13] I find dismissal is inappropriate in this case.

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[12]Given my holding that I have jurisdiction over the Defendants based upon the Massachusetts long-arm statute, I need not address whether I also have jurisdiction either based upon the service of process to the Defendants while present in this jurisdiction or on *in rem* jurisdiction.

[13]I find that any issues of comity that might arise regarding forum selection are encompassed by my consideration of the *forum non conveniens* issue.

"[T]here is ordinarily a strong presumption in favor of the plaintiff's choice of forum, which may be overcome only when the private and public interest factors clearly point towards trial in the alternative forum." Piper Aircraft Co. v. Reyno, 454 U.S. 235, 255, 102 S.Ct. 252, 70 L.Ed.2d 419 (1981) (hereinafter "Piper Aircraft "). Private interests include

> the relative ease of access to sources of proof; availability of compulsory process for attendance of unwilling, and the cost of obtaining attendance of willing, witnesses; possibility of view of premises, if view would be appropriate to the action; and all other practical problems that make trial of a case easy, expeditious and inexpensive.

Gulf Oil Corp. v. Gilbert, 330 U.S. 501, 508, 67 S.Ct. 839, 91 L.Ed. 1055 (1947) (hereinafter "Gilbert ").

> The public factors bearing on the question include[ ] the administrative difficulties flowing from court congestion; the "local interest in having localized controversies decided at home"; the interest in having the trial of a diversity case in a forum that is at home with the law that must govern the action; the avoidance of unnecessary problems in conflict of laws, or in the application of foreign law; and the unfairness of burdening citizens in an unrelated forum with jury duty.

Piper Aircraft, 454 U.S. at 241 n. 6, 102 S.Ct. 252 (quoting Gilbert, 330 U.S. at 508, 67 S.Ct. 839).

As discussed in my analysis of the Gestalt factors, *supra* section II.A.2.c, the Defendants do bear some inconvenience in litigating in this court. For instance, it will be expensive to get willing witnesses from Alberta to Boston. Furthermore, it may be difficult to get them to come at all because of this court's inability to order them to do so and the time and effort they would need to expend to attend. Nonetheless, I find these factors to be insufficient to overcome the presumption favoring the Plaintiff's forum selection for several reasons.

First, the Defendants have not identified any witnesses or evidence that would be unavailable as a result of trying this case in Boston. The significant cost of traveling here for the litigation is burdensome, but litigation, sadly, is an expensive proposition. There is nothing inordinate in the overall cost of this litigation in this forum.

Second, the public interest factors do not clearly favor trial in Alberta. This is also a matter of concern both to a Massachusetts corporation and to the Massachusetts people.

Third, if I were to dismiss this case so that it could be brought in Alberta, then the Plaintiff would face the same basic problems the Defendants do now. Furthermore, the parties would have to begin the case anew.

III. SUFFICIENCY AND LIKELIHOOD OF SUCCESS ON THE CLAIMS[14]

The Plaintiff asserts five claims against the Defendants in its First Amended Complaint: (1) trademark infringement, 15 U.S.C. § 1114(1); (2) trademark cyberpiracy, 15 U.S.C. § 1125(d);[15] (3) unfair competition and false designation, 15 U.S.C. § 1125(a); (4) state common law trademark infringement; and (5) state unfair trade practices, Mass. Gen. Laws ch. 93A §§ 2, 11. I will review each of these claims in turn to determine whether, and to what extent, a likelihood of success as to each supports the imposition of interlocutory relief

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[14]The Plaintiff has moved to strike the affidavit of Mikki Barry. To the extent the affidavit offers legal arguments and conclusions, it is inadmissible. The remaining portions that present information on the internet and its use are admissible as context. As my subsequent discussion will show, I have not significantly relied upon this affidavit.

[15]Although I am relying upon a publication of PL 106-113 for the text of the Anticybersquatting Consumer Protection Act, any references I make to the Act in this memorandum will use citations to the Act's intended United States Code sections.

before turning to the balance of hardships and public interest.[16] The treatment of likelihood of success on the claims will necessarily dispose of the contentions raised by the Defendants' Rule 12(b)(6) motion to dismiss.

A. Trademark Infringement, 15 U.S.C. § 1114(1)

Trademark infringement and unfair competition laws are meant to protect the public from confusion as to the source, affiliation, association, or sponsorship of goods or services. *See* 15 U.S.C. 1125(a)(1)(A); International Assoc. of Machinists and Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr., 103 F.3d 196, 200, 208 (1st Cir.1996) (hereinafter "IAM "); Star Fin. Servs., Inc. v. Aastar Mortgage Corp., 89 F.3d 5, 9 (1st Cir.1996) (hereinafter "Star"); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 23:8 (1999). "To win a trademark case, a plaintiff must show 1) that he uses, and thereby "owns," a mark,[17] 2) that the defendant is using that same or a similar mark, and 3) that the defendant's use is likely to confuse the public, thereby harming the plaintiff." DeCosta v. Viacom International, Inc., 981 F.2d 602, 605 (1st Cir.1992); *see also* Star, 89 F.3d at 9. The first two elements are plainly satisfied in this case; this case turns upon the third element.

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[16]The governing standard for preliminary injunctive relief requires that: A party seeking a preliminary injunction must establish that (1) it is substantially likely to succeed on the merits of its claim; (2) absent the injunction there is "a significant risk of irreparable harm"; (3) the balance of hardships weighs in its favor; and (4) the injunction will not harm the public interest. I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 33 (1st Cir.1998).

[17]The First Circuit has also established three prerequisite elements; the mark must (1) be used in commerce, (2) be nonfunctional, (3) be distinctive. *See* I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 36- 43 (1st Cir.1998). Neither party addresses these issues, but I note that these prerequisites are met in this case.

The "likelihood of confusion" test is the heart of trademark infringment. IAM, 103 F.3d at 200; Star, 89 F.3d at 10. In making a determination as to the likelihood of confusion, the First Circuit has directed assessment of eight factors:

> (1) the similarity of the marks; (2) the similarity of the goods [or services]; (3) the relationship between the parties' channels of trade; (4) the relationship between the parties' advertising; (5) the classes of prospective purchasers; (6) evidence of actual confusion; (7) the defendant's intent in adopting the mark; (8) the strength of the plaintiff's mark.

Star, 89 F.3d at 10 (quoting Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1205 (1st Cir.1983)); *see also* I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 43 (1st Cir.1998); IAM, 103 F.3d at 201; Hasbro, Inc. v. Clue Computing, Inc., 66 F.Supp.2d 117, 121-22 (D.Mass.1999). Of these eight factors, no one is determinative. IAM, 103 F.3d at 201. I will consider each factor to determine whether a likelihood of confusion exists.

1. Similarity of Marks

"Words may be recognized as similar because of sound, appearance, and meaning, and a finding of similarity may be based on appearance alone." Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812, 817 (1st Cir.1987) (hereinafter "Volkswagen ") (citations omitted); *see* Star, 89 F.3d at 10 (confusing similarity between "STAR MORTGAGE" and "AASTAR MORTGAGE"); Equine Technologies, Inc. v. Equitechnology, Inc., 68 F.3d 542, 546 (1st Cir.1995) (finding confusion between "EQUINE TECHNOLOGIES" AND "EQUITECHNOLOGIES") (hereinafter "Equine"); Aktiebolaget Electrolux v. Armatron International, Inc., 999 F.2d 1, 3 (1st Cir.1993) (finding "Weed Eater" similar to "Leaf Eater") (hereinafter "Electrolux "); Volkswagen, 814 F.2d at 817 (holding "Beetle" similar to "Beetle Barn"); CCBN.com, Inc. v. c-call.com, Inc., 73 F.Supp.2d 106, 112 (D.Mass.1999)

(finding "StreetEvents.com" similar to "StreetFusion.com") (hereinafter "CCBN.com"). In the present case, the marks at issue are significantly similar in sound and appearance; they differ only in the addition of "s.com." The addition of the ".com" is of little importance in distinguishing the two marks because it is a generic locator for domain names of web sites dedicated to commercial use. *See* Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1055 (9th Cir.1999); CCBN.com, 73 F.Supp.2d at 112. In terms of meaning, while the northern lights or aurora borealis are different than the Northern Light clipper ship, the distinction is not a commonly understood one. It is by no means sufficient to overcome the significant similarities in sight and sound.

An evaluation of similarity, however, does not end here. "[S]imilarity is determined on the basis of the designation's total effect and infringement does not exist, though the marks be identical and the goods very similar, when the evidence indicates no [likelihood of confusion]." IAM, 103 F.3d at 203-04 (citations omitted and quoting James Burrough Ltd. v. Sign of the Beefeater, Inc., 540 F.2d 266, 274 (7th Cir.1976)). For instance, in Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1205 (1st Cir.1983), and Hasbro, Inc. v. Clue Computing, Inc., 66 F.Supp.2d 117, 122 (D.Mass.1999), the similarity between marks was held diminished where the allegedly infringing marks were used in conjunction with either the logos or name of the manufacturer, and, in CCBN.com, the Court found the similarity diluted by the "vastly different design, layout, and color schemes on their web pages." CCBN.com, 73 F.Supp.2d at 112.

In the case before me, by contrast, the relevant web sites are not vastly different. Instead, aspects of the northernlights.com web site design in fact enhance the likelihood of confusion. (Suess Aff. Ex. I.) First, the prominent display of a search box with the general caption "Search NorthernLights.com" only reinforces a user's belief that he/she has actually accessed an

Internet search engine. (Suess Aff. Ex. I.) Second, the placement of a reference to "Northern Light Search Engine" among the northernlights.com business listings suggests an association between the Plaintiff and the Defendants. (Suess Aff. Ex. I.) Finally, especially when the Northern Light Search Engine was the featured listing, the inference arises that the search box utilizes the Northern Light Search Engine technology. (Winston Aff. § 4.) The similarities between the Plaintiff's and Defendants' marks weigh heavily in favor of a likelihood of confusion.

2. Similarity of Services

The key question here is to what extent are the Plaintiff's and Defendants' services related in the minds of the public. *See* Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1056-57 (9th Cir.1999); E. Remy Martin & Co., S.A. v. Shaw-Ross Inter. Imports, 756 F.2d 1525, 1530 (11th Cir.1985) (finding public would believe producer of brandy and cognac would also enter wine production).

In Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1205-06 (1st Cir.1983), the plaintiff's products consisted mainly of local anesthetics, cardiovascular medicines, and prefilled syringes, and the allegedly infringing product was a 350 to 500 pound analyzer used in hospital chemistry laboratories. While, generally speaking, both were used in the medical or health care field, the dramatic physical dissimilarities between the two products combined with the fact the plaintiff's products were not used in laboratories led the Court to find that the products themselves would not foster confusion. *See also* Hasbro, Inc. v. Clue Computing, Inc., 66 F.Supp.2d 117, 122-23 (D.Mass.1999) (finding no similarity between the game CLUE and consulting services offered by Clue Computing even in light of Hasbro's intended use of its web site for technical support of the CD-ROM version of CLUE).

In Public Service Co. v. Nexus Energy Software, Inc., 36 F.Supp.2d 436, 437 (D.Mass.1999), the plaintiff offered an Internet site that directed customers to vendors who supply energy efficient products; the defendant operated an Internet site that analyzed customers' energy needs. The Court held "[a]though there are some differences in the services offered, both parties offer consumers information relating to energy services." Id. at 439. *See also* Equine, 68 F.3d at 546 (recognizing strong similarity between hoof care products even though price differential and sophisticated purchasers).

In the present case, the Plaintiff's and Defendants' services are likely to be related in the minds of the public as both offer web-based services to navigate the World Wide Web. It would be very different if a web user accessed northernlights.com and found a site advertising oil drilling. *See* Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1056 (9th Cir.1999). Here, while the scope of the navigational aid differs, the two web sites exist for the same basic purpose. Furthermore, the Defendants' web site specifically only offers links to sites with a relation to the phrase "Northern Light." The common purpose of the two sites and the strong affiliation of the content on northernlights.com with the Plaintiff's registered mark are likely to cause the public to associate the two services.

3. Channels of Trade

The channels of trade are identical; both function on the Internet. This factor suggests confusion.

4. Channels of Advertising

The parties have distinctly different approaches to advertising. The Defendants do not advertise at all beyond their web site. (Def.'s Supp. Mem. re: Opp. Pl.'s Mot. Prelim. Injunc. filed Dec. 22, 1999.) The Plaintiff has engaged in a significant multimedia advertising campaign to improve its brand awareness. (Suess Aff. § 10.) The question, however, is not completely one of where, how and to what extent the two

parties experience advertising overlap, but also the degree to which the two parties are targeting the same audience. *See* Star, 89 F.3d at 10.

In Star, the defendant argued that because the plaintiff only advertised in one of the many publications in which the defendant advertised, the likelihood of confusion was minimal. 89 F.3d at 10. The Court responded

> ... This argument, however, is premised upon the unsupportable assumption that because some of the advertising channels differed, distinct classes of consumers were reached and the relevant consuming public would view mortgage- originating advertisements in only one source, and hence, would not be confused. The evidence, however, supports a finding that STAR and AASTAR targeted the same classes of prospective purchasers in the same geographical areas, regardless of the particular advertising channels employed.

Id.

In the present case, the parties advertise at their own sites on the web. *See* Digital Equip. Corp. v. AltaVista Technology, Inc., 960 F.Supp. 456, 477 (D.Mass.1997) (finding similarity of advertising based upon both parties advertising on own web sites even though at least Digital was likely to have advertised elsewhere). Furthermore, the Plaintiff raises the argument that the Defendants do not advertise because, instead, they exploit the Plaintiff's advertising efforts by targeting those users who are seeking the Plaintiff's web site but accidentally add an "s" to the domain name. I find this argument somewhat convincing. Nonetheless, given the significant disparity in the breadth of advertising of the two parties, I find that this factor is not particularly helpful to either side's case.

5. Classes of Prospective Users

"On this point, the requisite inquiry is not limited merely to determining whether the class of prospective purchasers is the same or different. Instead, a court called upon to assay likelihood of confusion must ponder the sophistication of the class." IAM, 103 F.3d at 204. In this case, the Plaintiff and the Defendants both target Internet users; thus, the initial issue regards the sophistication of the prospective users.

A significant portion of the Plaintiff's users are somewhat sophisticated individuals both in their general background and in their Internet use. For instance, as of May 1999, seventy-one percent of the Plaintiff's users had been using the Internet for greater than two years. (Mullen Mem. re: Harris Black Market Research, Def.'s Exs. to Supp. Mem. in Opp. Prelim. Injunc. Ex. 5.) Furthermore, the Plaintiff's web site focuses "on doing detailed searches for small businesses and consumers." (Ronald Rosenberg, *Godsend--and a threat,* Boston Globe, June 30, 1999, Suess Aff. Ex. B.) But, not all of the users are sophisticated, and, in fact, the Plaintiff's advertising campaign partially aims simply to increase traffic at the web site. (Mullen Presentation at N001272, Def.'s Exs. to Supp. Mem. in Opp. Prelim. Injunc. Ex. 8.) Given this blend regarding the sophistication of the users, what level of sophistication should I attribute to the reasonably prudent user?

The Third Circuit in Ford Motor Co. v. Summit Motor Prods., Inc., 930 F.2d 277, 293 (3rd Cir.1991), applied the standard that "when a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class." *Accord* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 23:100 (1999). Other potential standards exist such as averaging the sophistication of the relevant users, but I find the standard employed by the Third Circuit appropriate because a mark owner should be accorded the benefits of its mark throughout the range of its prospective

customers.[18] As such, in this case, the applicable user for purposes of applying the likelihood of confusion test is one of ordinary sophistication.

A user of ordinary sophistication will likely be confused. Beyond simply the high likelihood of confusion due to the similarities between the Plaintiff's and Defendants' web sites, the primary services provided are free. "[W]hen dealing with inexpensive products, customers are likely to exercise less care, thus making confusion more likely." Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1060 (9th Cir.1999); *see also* Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206 (1st Cir.1983) (finding less likelihood of confusion where products expensive); CCBN.com, 73 F.Supp.2d at 113 (same). Furthermore, the interaction takes place on the Internet where users "are more likely to be confused as to the ownership of a web site than traditional patrons of a brick- and-mortar store would be of a store's ownership." Brookfield Communications, 174 F.3d at 1057.

6. Actual Confusion

The Plaintiff does not submit any direct evidence that users were actually confused as to the source, affiliation, association, or sponsorship of the services offered at the Defendants' web site. The Plaintiff points to Burgar's statement in an email to Winston that, over the course of a year, the Defendants had been contacted by a few people looking for the Plaintiff's web site. (Pl.'s Rep. Mem. re: Prelim. Injunc. filed Jan. 10, 2000 at 11, Winston Aff. Ex. A.) The Plaintiff also relies upon Ms. Winston's statement that several thousand users a day who access the Plaintiff's web site come from the Defendants' web site. (Pl.'s Rep. Mem. re: Prelim. Injunc. filed Jan. 10, 2000

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[18]While I note that other standards could be applied, I am not aware of any cases that apply a different standard.

at 11, Winston Aff. § 5.) Neither of these pieces of evidence, however, indicate anything more than initial confusion which is not cognizable under trademark law in the First Circuit. See Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1207 (1st Cir.1983) (holding temporary initial confusion insufficient basis for infringement claim); Hasbro, Inc. v. Clue Computing, Inc., 66 F.Supp.2d 117, 125 (D.Mass.1999) (rejecting initial confusion due to domain name as basis for infringement claim); *see also* Teletech Customer Care Management (Cal.), Inc. v. Tele-Tech Co., Inc., 977 F.Supp. 1407, 1414 (C.D.Cal.1997) ("Teletech has not presented sufficient evidence to demonstrate a likelihood of confusion under the trademark laws. TeleTech thus far has only demonstrated an initial confusion on the part of web browsers using the domain name 'teletech.com' but finding the Defendant's web site. This brief confusion is not cognizable under the trademark laws."). *But see* Interstellar Starship Servs. v. Epix, 184 F.3d 1107, 1110 (9th Cir.1999) (recognizing "a brand of confusion called 'initial interest' confusion, which permits a finding of a likelihood of confusion although the consumer quickly becomes aware of the source's actual identity"). Nonetheless, the lack of actual confusion is not particularly significant in this case. While proof of actual confusion is important, the lack of actual confusion is meaningful only in cases where marks have been side-by-side in the same market for long periods of time or when goods or services have substantial disparities. *See* Volkswagen, 814 F.2d at 818; Brookfield Communications, 174 F.3d at 1050 ("[D]ifficulties in gathering evidence of actual confusion make its absence generally unnoteworthy."); Data Concepts, Inc. v. Digital Consulting, Inc., 150 F.3d 620, 626 (6th Cir.1998) ("[T]he lack of evidence of actual confusion is not significant unless the circumstances indicated that such evidence should have been available."). In the case before me, no substantial disparities between the services exist to make the lack of actual

confusion significant; therefore, I need only focus on whether the two web sites coexisted for a time sufficient to raise the presumption that no evidence of actual confusion is significant.

In the First Circuit, courts have only attributed significance to a lack of actual confusion in cases in which the relevant products or services coexisted for at least several years. Electrolux, 999 F.2d at 3 (finding significance after six years); Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 490-91 (1st Cir.1981) (four years); Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 377-78 (1st Cir.1980) (finding three and half years combined with striking differences between containers makes lack of actual confusion significant); Purolator, Inc. v. Efra Distributors, Inc., 524 F.Supp. 471, 476 (D.P.R.1981) (not placing significance on lack of evidence of actual confusion where suit filed three months after marketing of defendant's product began); *see also* Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1227 (2nd Cir.1987) (four months not sufficient); Frank Brunckhorst Co. v. G. Heileman Brewing Co., Inc., 875 F.Supp. 966, 980 (E.D.N.Y.1994) (indicating lack of actual confusion was of diminished importance because only coexisted seven months). In this case, the Defendants' web site at northernlights.com only operated from April 1999 until September 1999 when it was blacked out as a result of my initial interlocutory order. This period of time is not sufficient to create the presumption that a lack of evidence of actual confusion is significant. Therefore, I find that, at best, the lack of evidence on this point only slightly favors the Defendants' position.

7. Intent

As discussed in section III.C.4 *infra.*, I find the Defendants acted with a bad faith intent to profit by the use of the Plaintiff's mark.

8. Strength of the Mark

"In assessing a mark's strength, the trier of fact considers evidence of the length of time the mark has been used, its renown in the plaintiff's field of business, and the plaintiff's actions to promote the mark." Star, 89 F.3d at 11; *see also* Equine, 68 F.3d at 547.

In IAM, 103 F.3d at 206, the Court found IAM's mark to be strong because it had been duly registered and widely promoted for over thirty years. In Equine, the Court found the plaintiff's mark to be moderately strong in light of its use for four years, the goods upon which it was affixed were actively marketed in 74 print advertisements, the plaintiff had received favorable publicity in the horse world, the plaintiff had successfully compelled an infringing competitor to change its name, and the United States Patent and Trademark Office had rejected a similar mark. 68 F.3d at 547. In Public Service Co. v. Nexus Energy Software, Inc., 36 F.Supp.2d 436, 439 (D.Mass.1999), the Court found the plaintiff's mark to be sufficiently distinct because it had been used for over two years and the plaintiff had advertised the mark in various ways. Finally, the Court in Star found the plaintiff's mark to be relatively weak although it had been in the relevant market for over two years and the plaintiff had expended several thousand dollars per month in advertising. 89 F.3d at 11.

In this case, elements favoring strength include the accolades the Plaintiff has received, the registration of the mark with the United States Patent and Trademark Office, and the seven million dollars the Plaintiff has recently spent advertising. (Suess Aff. § 2; Suess Aff. Ex. F.; Suess Dep. 309, Def.'s Exs. to Supp. Mem. in Opp. Prelim. Injunc. Ex. 19.) Factors reducing the strength of the Plaintiff's mark are its limited active life of two and a half years and a modest aided and unaided brand awareness among Internet users of twenty

percent and less than five percent respectfully.[19] (Suess Dep. 309-10.) Given these factors, I find the Plaintiff's mark to fall in the spectrum of cases close to the marks in Equine and Public Service Co.; therefore, I find the Plaintiff's mark is moderately strong.

9. Conclusion

I note that "[i]n the Internet context, in particular, entering a web site takes little effort--usually one click from a linked site or a search engine's list; thus, Web surfers are more likely to be confused as to the ownership of a web site than traditional patrons of a brick-and-mortar store would be of a store's ownership." Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1057 (9th Cir.1999). This contextual circumstance combined with the significant similarities between the marks, the similarities between the services, the overlapping channels of trade, the ordinary sophistication of the users, the Defendants' bad faith, and the moderate strength of the Plaintiff's mark lead me to conclude a high likelihood of confusion exists in this case and, subsequently, a high likelihood of success on the merits of the trademark claim.

B. *Trademark Cyberpiracy,* 15 U.S.C. § 1125(d)

Congress recently passed the Anticybersquatting Consumer Protection Act primarily in an effort to stop "cybersquatters who register numerous domain names containing American trademarks or tradenames only to hold them ransom in exchange for money" H.R.Rep. No. 106-412, at 5 (Purpose and Summary). In order to succeed on a claim under the Act, a plaintiff must prove the following elements:

1) the plaintiff owns a mark;

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[19]Aided brand awareness exists when a person polled recognizes the brand Northern Light when asked about it. Unaided brand awareness exists when a person who is asked to name six search engines volunteers Northern Light among those six. (Seuss Dep. 310.)

2) the defendant registers, traffics in or uses a domain name that
   i) in cases in which the plaintiff's mark was distinctive at the time of the defendant's registration of the domain name, the domain name is identical or confusingly similar to the plaintiff's mark;
   ii) in cases in which the plaintiff's mark was famous at the time of the defendant's registration of the domain name, the domain name is identical or confusingly similar to or dilutive of the plaintiff's mark;
   iii) in cases in which the plaintiff's mark is protected by 18 U.S.C. 706 or 36 U.S.C. 220506, the domain name is the protected mark;[20]
3) the defendant has a bad faith intent to profit from plaintiff's mark.[21]

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[20]This potential basis for a claim will not be discussed further in this memorandum because it does not apply in this case.

[21]15 U.S.C. § 1125(d)(1)(A) provides that:
A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person--
(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and
(ii) registers, traffics in, or uses a domain name that--
(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or
(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36, United States Code.

In the present case, the first element is met. The Plaintiff owns the federally registered NORTHERN LIGHT trademark. (Suess Aff. Ex. F.)

As for the second element, several issues arise. First, at the time of the Defendants' registration of northernlights.com, was the Plaintiff's mark then deemed a mark? Second, was it distinctive and/or famous? [22] Third, is the Defendants' domain name, northernlights.com, identical or confusingly similar to the Plaintiff's mark?[23]

1. Mark?

Section 15 U.S.C. § 1127 defines mark to include "any trademark, service mark, collective mark, or certification mark." The section further provides that a service mark is

> any word, name, symbol, or device, or any combination thereof--
>
> (1) used by a person, or
>
> (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,
>
> to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

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[22]A "famous" mark is by necessity also "distinctive," but the reverse is not true. See I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 47 (1st Cir.1998).

[23]I will not consider whether the Defendants' domain name is dilutive of the Plaintiff's mark because as discussed in section III.C.2 *infra,* the Plaintiff's mark was not "famous" at the time of the Defendant's registration of it.

15 U.S.C. § 1127.[24]

The Defendants registered the domain name, northernlights.com, on October 31, 1996. (Suess Aff. Ex. H.) The Plaintiff's trademark, NORTHERN LIGHT (R), was not used in commerce until August 15, 1997 and was not registered until February 23, 1999. (Suess Aff. Ex. F.) Nonetheless, by October 31, 1996, NORTHERN LIGHT (R) already met the second definition of service mark because the Plaintiff had applied for registration of NORTHERN LIGHT (R) on September 23, 1996 and intended to use the mark in commerce. (Suess Aff. Ex. F.)

2. Distinctive or Famous?

A mark is distinctive if it is either inherently distinctive or has acquired a secondary meaning. *See* I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 39 (1st Cir.1998). Famousness requires national renown which is "a great deal more" than the secondary meaning sufficient to establish distinctiveness. Id. at 47. As of the date of the Defendants' registration of northernlights.com, October 31, 1996, NORTHERN LIGHT (R) was an inherently distinctive mark but could not have been famous or even had a secondary meaning as it had not been used in commerce at that time.

> In analyzing whether a product's mark is distinctive, courts have often divided marks into the five categories set forth in Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir.1976): (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful. Suggestive, arbitrary, and fanciful marks are

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[24]I have quoted the definition of "service mark" found in 15 U.S.C. § 1127 instead of the definition for "trademark" because the Plaintiff was in fact granted a service mark. (Seuss Aff. Ex. F.) For purposes of this discussion, both definitions yield the same outcome. Finally, I note that I use the term "trademark" when referring to NORTHERN LIGHT (R) because it is common parlance.

> deemed inherently distinctive; descriptive marks receive protection only upon a showing that they have acquired secondary meaning; and generic marks are not protectable.

I.P. Lund Trading v. Kohler Co., 163 F.3d at 39 (citations omitted). With regards to using NORTHERN LIGHT (R) to identify an internet search engine, NORTHERN LIGHT (R) is an arbitrary mark and, therefore, inherently distinctive. An arbitrary mark is one that uses "words, symbols, pictures, etc. that are in common linguistic use but which, when used with the goods and services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 11:11 (1999). Nothing in the mark NORTHERN LIGHT (R) suggests computers, the Internet, search capability, information, etc.

3. Identical or Confusingly Similar

Northernlights is not identical to NORTHERN LIGHT (R); thus, this claim turns upon whether northernlights.com is "confusingly similar" to NORTHERN LIGHT (R). But what does Congress mean by "confusing similar?" Does Congress want the courts to simply compare the domain name itself to the trademark itself or to apply the traditional and more comprehensive trademark infringement test of "likelihood of confusion?" *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 23:4 (1999) (indicating the phrase "confusing similar" has been used both to refer to the similarity of marks and to the overall likelihood of confusion). I find that for purposes of this Act Congress intended simply a comparison of the mark and the allegedly offensive domain name.

The plain language of the law indicates a direct comparison between the protected mark and the domain name itself: "a domain name that ... is identical to or confusingly similar to that mark." 15 U.S.C. § 1125(d)(1)(A)(ii); *see also* J. Thomas

McCarthy, *McCarthy on Trademarks and Unfair Competition* 23:4 (1999) (noting "confusingly similar," when appropriately modified in context, can refer solely to the similarity of marks themselves). Not only is this language indicative in and of itself, it is significant in its difference from the language found in 15 U.S.C. § 1114(1), the federal trademark infringement statute. The language of 15 U.S.C. § 1114(1) indicates a contextual comparison of marks as opposed to a direct comparison;[25] a person using an exact copy of a trademark in commerce still only infringes if the use is likely to cause confusion.[26]

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[25]15 U.S.C. § 1114(1) provides in relevant part
Any person who shall, without the consent of the registrant--
(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

[26]"Confusingly similar" is grouped with both "identical" and "dilutive" in the statute. "Confusingly similar" 's grouping with "identical" suggests the interpretation I have accorded it, but I note "dilutive" may suggest otherwise. I have not given the grouping with "dilutive" much significance because of the reasons given in the main text of this memorandum and the existence of an interpretation of "dilutive" that accords with my interpretation of the statute. For instance, the domain name di zneepresentssexkittens.com is likely inherently dilutive of DISNEY (R) while not being "identical" or "confusingly similar.".

The legislative history further supports the interpretation that this element merely requires a comparison of the domain name and mark. Congress's goal with this Act was to stop cybersquatting, the practice of "individuals seeking extortionate profits by reserving Internet domain names that are similar or identical to trademarked names with no intention of using the names in commerce." H.R. Rep. 106-412, at 6 (Background and Need for the Legislation). Congress was concerned not with activities that approximated infringement but, instead, with domain name prospecting. To interpret "confusingly similar" as shorthand for the "likelihood of confusion" infringement test would largely undermine Congress's goal of stopping individuals who own domain names that approximate distinctive marks but do not actively use the domain names other than to make them available for sale. Furthermore, Congress intended to use the bad faith element of a claim not the "confusingly similar" element to tailor the statute narrowly: "This bill is carefully and narrowly tailored, however, to extend only to cases where the plaintiff can demonstrate that the defendant registered, trafficked in, or used the offending domain name with bad-faith intent to profit from the goodwill of a mark." H.R. Conf. Rep. 106-464. In the present case, northernlights.com is "confusingly similar" to NORTHERN LIGHT (R).

4. Bad Faith Intent to Profit

Finally, the Plaintiff must prove the Defendants' bad faith intent to profit from the Plaintiff's mark. Congress has set forth the following nine nonexhaustive factors a court may consider in determining bad faith:

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43.

15 U.S.C. § 1125(d)(1)(B)(i). Congress further provided "[b]ad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful." 15 U.S.C. § 1125(d)(1)(B)(ii).

I begin by addressing the "escape clause," 15 U.S.C. § 1125(d)(1)(B)(ii). The Defendants argue they prevail based on this clause because the "Plaintiff has not affirmatively proven the *absence* of any reasonable basis for the Defendants' use of this domain name." (Def.'s Rep. Mem. re: Mot. to Dismiss for Lack of Juris. at 36-37.) (emphasis in original) I conclude otherwise.

Because the "escape clause" turns upon the beliefs of the Defendants, the Defendants bear at least the initial burden. Here, the Defendants have bandied about a variety of explanations--the northernlights.com web site is an experiment in a new business model, it is a site for those interested in the aurora borealis, it is a community page for those organizations with some relationship with the phrase "Northern Light", and it was published to reduce inquires of the Defendants regarding how to find the Northern Lights Ministry homepage.[27] Even without considering any other evidence of bad faith, as I will shortly, the simple fact that the Defendants regularly change their explanation for the web site indicates to me that these

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[27]I have disregarded the fact that northernlights.com is licensed to Flairmail for vanity email purposes because the "use" in question is the posting of a web site at northernlights.com.

explanations are likely mere pretexts. Therefore, I will not dismiss this claim based upon the "escape clause."

Now, I turn to the analysis of bad faith. Two pieces of evidence undermine the allegation of bad faith: (1) the Defendants initially refused to sell northernlights.com and (2) they have used the domain name for email purposes for several years now. These, however, are outweighed by the Defendants' behavior of targeting trademarked names, creating fictional entities to register them, and offering dubious explanations for the selection of these domain names.

The Defendants collectively have registered thousands of domain names that are often identical or confusingly similar to the marks of others. The names include "rollingstones.com", "derekjeter.com", "westerndigital.com", "gonewiththewind.com", "yankees1.com", "evinrude.com", "stcroixrod.com", and "hewlettpackard.com" among many others. The Defendants searched through books, lists, and the Internet to seek out popular names to register. (Burgar Dep. at 106, Pollack Aff. Ex. A.) The Defendants also often created fictional clubs to register domain names. For instance, in order to get loislane.com, the Defendants represented to NSI that they were the Lois Katherine Lane Club. Regarding the Lois Katherine Lane Club, the following exchange took place at Burgar's deposition:

Q: Did you ever advise Network Solutions that Lois Katherine Lane was just a fake name?

A: It's not a fake name, somebody in the world probably has it.

Q: That when you provided the name Lois Katherine Lane you had no particular person to whom you were identifying?

A: It's a club.

Q: It's the Lois Katherine Lane Club?

A: It could still be a club.

Q: How many members are there of that club?

A: None.

(Burgar Dep. at 182-83, Pollack Aff. Ex. A.) In an effort to explain the practice of creating clubs, Burgar stated that in order to register celebrity domain names the Defendants needed to adopt this "technical 'workaround.' " (Burgar Aff. at n.1)

In addition to Burgar's dubious explanation that he registered loislane.com for all the Lois Katherine Lane's out there, he has similarly suspicious explanations for other domain names. For instance, he also claims to have registered "evinrude.com," "muriel.com," and "givenchy.com" after people. Burgar claims of "yankees1.com" that "[w]e're not using it in reference to a sports team ... it's a colloquial statement for Americans." (Burgar Dep. at 165.) He claims this in spite of the fact that he has also registered mets1.com, redsox1.com, dodgers1.com, etc.

This practice of registering domain names that are identical or similar to others' marks has resulted in the Defendants receiving numerous cease and desist letters. (Pollack Aff Exs. C-Y.) The Defendants have taken a variety of responses to these cease and desist letters. In some cases, the Defendants have thrown away the letters away upon receipt. (Burgar Aff. at 163, Pollack Aff. Ex. A.) In others, the Defendants have stopped using the domain names but have retained ownership of them. (Burgar Aff. at 177, 184.) And, in at least one case, the Defendants have sold the disputed domain name. (Burgar Aff. at 148.)

The variety of responses by the Defendants to the cease and desist letters is not surprising. Burgar exhibits a propensity to use different approaches to maximize the profitability of domain names. First, Seuss, in his affidavit, states that in 1996 Burgar "described a business model for his operation that involved tying up many web addresses and domain names indefinitely without intention of using them, waiting for them to become more valuable, and then selling them at inflated prices." (Seuss Aff. § 14.) Second, Burgar is currently

negotiating with the Yankees and other sports teams regarding licensing arrangements to use the team domain names he owns. (Burgar Dep. at 164-65.) Third, Burgar was found in contempt of a consent judgment issued by the Southern District of New York because after agreeing to the judgment, Burgar disobeyed it by maintaining ownership of "cheri.com" and purportedly selling it to a third party. (Pollack Aff. Ex. AA.)

Finally, in this case, although the Defendants initially refused to sell northernlights.com, the Defendants shortly thereafter posted the northernlights.com web site and attempted to use it to entice the Plaintiff to participate in the Defendants' new "business model." (Winston Aff. Ex. A.) The Plaintiff refused, sent a cease and desist letter, and eventually brought this suit. Burgar, through his counsel, has since indicated his willingness to sell at least the northernlights.com web site pointer to the Plaintiff if "the price is attractive enough." (Settlement Ltr. at 1, Def.'s Mem. re: Recon. Restraining Order Ex. 20.) Based upon the evidence, I find the Defendants will likely be found to have acted with a bad faith intent to profit from the Plaintiff's mark.

5. Conclusion

There is a high likelihood, given the Defendants' bad faith intent to profit from Plaintiff's distinctive mark, that Plaintiff will succeed on the merits of its Anticybersquatting claim.

C. Unfair Competition and False Designation, 15 U.S.C. § 1125(a)

In this case, where the basic allegation is trademark infringement, the evaluation of the Plaintiff's 15 U.S.C. § 1114(1) claim suffices to establish likelihood of success on this claim. *See* Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc., 982 F.2d 633, 639-40 (1st. Cir.1992) ("[T]he key question ... under [15 U.S.C. § 1125(a)] is whether material differences likely to confuse consumers exist ....").

D. *State Common Law Trademark Infringement*

Because "[l]ikelihood of confusion is ... an essential element of a claim of trademark infringement, whether asserted under Massachusetts law or federal law," evaluation of the Plaintiff's 15 U.S.C. § 1114(1) claim suffices to establish likelihood of success on this claim. *See* Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 486-87 (1st. Cir.1981).

E. *State Unfair Trade Practices, Mass. Gen Laws ch. 93A §§ 2, 11.*

"As with [15 U.S.C. § 1125(a)], the essential element of the action under the Massachusetts Consumer Protection Act, Mass.Gen.Laws ch. 93A, §§ 2, 11, is that defendant's use of a mark caused confusion among customers as to the source of the plaintiff's product." R.J.Toomey Co. v. Toomey, 683 F.Supp. 873, 879 (D.Mass.1988). Therefore, once again, my previous discussion suffices to establish likelihood of success on the merits.

IV. PRELIMINARY INJUNCTION

The plaintiff's likelihood of success on Counts I, II, III IV and V supports continuation of the interlocutory order I previously imposed in this matter.[28] Before turning to the balancing factors, I must emphasize the importance of the likelihood of confusion findings to the preliminary injunction calculus. "It has been held that when one adopts a mark similar to one already in use, there is an affirmative duty to avoid any likelihood of confusion." Volkswagen, 814 F.2d at 817.

A. *Irreparable Harm*

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[28]Given my decision as to the preliminary injunction, the Defendants' Motion to Dismiss for Failure to State a Claim and Motion for Rule 11 Sanctions for failure to conduct adequate investigation will be denied. Furthermore, the parties' cross-motions to compel are denied without prejudice. Discovery issues will be addressed at a scheduling conference 45 days from now to discuss the posture of this case.

"In the trademark context, 'irreparable harm may be shown even in the absence of actual injury to plaintiff's business based on plaintiff's demonstration of a likelihood of success on the merits on its claim.' " I.P. Lund Trading v. Kohler Co., 163 F.3d 27, 33 (1st Cir.1998) (citations omitted and quoting Calamari Fisheries, Inc. v. The Village Catch, Inc., 698 F.Supp. 994, 1013 (D.Mass.1988)). The existence of irreparable harm is even more insistent given the likelihood of a violation of the Anticybersquatting Act.

B. *Balance of Hardships*

Given the significant resources spent by the Plaintiff in developing and advertising its service and the relatively minor investment of the Defendants, this factor favors interlocutory relief for the plaintiff.

C. *Public Interest*

The public interest, expressed in a developing statutory regime, will best be served in the interim by a solution that diminishes the possibility of confusion but nevertheless permits the public access to Defendants' legitimate expression and services.

D. *Conclusion*

Based upon an evaluation of the several factors relevant to preliminary injunction analysis, I find that the interlocutory relief I have ordered shall remain in place for the remainder of this case.

V. PLAINTIFF'S CONTEMPT MOTION

The Plaintiff has filed a contempt motion on the basis that the Defendants violated the interlocutory order I previously entered by changing the content of Defendants' web site reached upon clicking on one of the court ordered links. On September 2, I ordered the Defendants to black out the web site located at www.northernlights.com and place designated text there instead. The screen was to read

IF YOU ARE LOOKING FOR FLAIRMAIL, THE FREE E-MAIL SERVICE, FOUND AT www.flairmail.com, *click here*

IF YOU ARE LOOKING FOR THE NORTHERN LIGHT SEARCH ENGINE, FOUND AT www.northernlight.com, *click here*

IF YOU ARE LOOKING FOR BUSINESSES THAT ARE LISTED WITH THE NORTHERN LIGHTS COMMUNITY (Not affiliated with the Northern Light search engine), *click here*

The Defendants did this. Subsequently, on September 12, 1999, although the Defendants did not change this greeting page, they changed the content reached when the third link was clicked. Instead of going to a list of businesses, the link connected to a discussion of this case.

"[C]ivil contempt must be established by clear and convincing evidence and the underlying order must be clear and unambiguous in its terms." Gemco Latinoamerica, Inc. v. Seiko Time Corp., 61 F.3d 94, 98 (1st. Cir.1995). Here I find no clear and convincing evidence exists supporting a contempt finding.

Because the link specifically says "If you are looking for Businesses," one could understand the order to mean that only businesses will be listed at the subsequent site. However, one could also understand the order to control only the content of the initial page.

While I am of the view that the first reading would be the more commonly understood one, the second reading is within the fair meaning of the order. More importantly, the new content merely apprizes people of this dispute, an activity which the Defendants should be free to undertake. (If the Plaintiff wishes to offer its own account of the proceedings in this case, it is free to do so as well.) Contempt is inappropriate. Nor do I find any reason to alter the interlocutory order either with

regard to content reached via the links or with regard to the designated text.

VI. CONCLUSION

For the reasons stated above:

I will not modify the Preliminary Injunction previously established.

I GRANT the Plaintiff's motion to strike Mikki Barry's affidavit to the extent the affidavit contains legal arguments or conclusions.

I DENY Plaintiff's contempt motion.

I DENY Defendants' motion to dismiss based on a lack of jurisdiction.

I DENY Defendants' motion to dismiss for failure to state a claim.

I DENY Defendants' motion for sanctions.

I DENY WITHOUT PREJUDICE the parties' cross-motions to compel.

The clerk is directed to set this matter down for a scheduling conference no earlier than 45 days from today. Five business days before the scheduling conference, the parties shall file a joint status report and a proposed scheduling order to provide an agenda for the conference.

/s/ Douglas P. Woodlock
United States District Judge